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## The Devil Wears Prado: A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion

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# **The Devil Wears Prado:<sup>1</sup> A Look at the Design Piracy Prohibition Act and the Extension of Copyright Protection to the World of Fashion**

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1. Many counterfeit and knockoff artists attempt to circumvent the little protection provided fashion designs by altering registered trademarks. For example, in the film "Serendipity," a street vendor sold "Prado" wallets meant to look like Prada to New York City tourists. SERENDIPITY (Simon Fields Productions 2001). While trademark law theoretically protects fashion design by preventing the use of a designer's trademarked name or symbol on a handbag or article of clothing, without protection of the *design itself*, these alterations are often enough to avoid liability. See discussion *infra* Part III. Other examples include: Goach in lieu of Coach, and Gocci in lieu of Gucci.

## I. INTRODUCTION

I have spent much of my life ogling back-issues of fashion magazines and coveting the couture garments that grace their pages. And while my “passion for fashion” was not readily understood by my parents, they did their best to appreciate my desire to study fashion as an undergraduate, stood by me when I moved to New York to surrender myself to the fashion department of W Magazine, and occasionally financially indulged my love for the trade and the art it produces. You can imagine my delight last Christmas when I opened a gift containing the Marc Jacobs handbag that had been the object of my desire for at least four months. My joy quickly dissipated, however, when after careful inspection I realized that this highly venerated bag was a fake! My parents insisted that the online site they purchased it from guaranteed its authenticity.<sup>2</sup> This may have been true, but I had invested inordinate amounts of time inspecting every detail and making it my business to know these bags, and this one I knew was counterfeit. In the end, my parents and I, both embarrassed, returned the bag with much scolding to the seller, and repurchased an original from an authorized dealer where authenticity was more assured.

Shortly after, in the pages of Harper’s Bazaar, I read the tale of another fashionista who had been duped in much the same way.<sup>3</sup> In fact, this

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2. Claiming authenticity is a common way for counterfeit “e-tailors” to make purchasers believe that their merchandise, while discounted, is still original. See Cynthia Nellis, *Counterfeit Fashion*, About.com: Women’s Fashion, <http://fashion.about.com/cs/tipsadvice/a/fakingit.htm> (last visited Jan. 24, 2007) (“Many sites also use . . . ‘authentic,’ ‘genuine’ and other enticing adjectives—to describe their fashion items. It’s only by reading carefully through the descriptions will you see comments like ‘Inspired by . . .’ to let you know that the merchandise isn’t an exact copy (which the retailers claim gives them immunity from trademark infringement).”). It is important to note that while the website which “guarantees” authenticity would likely be liable in the event that they are caught, the consumer is not often in the position to prove that the purchased item is counterfeit. And, even if authenticity could be disproved, the everyday consumer is not likely to bring an action against an online retailer.

3. See Jan Goodwin, *The Human Cost of Fakes: Counterfeiting Has Become the Crime of the 21<sup>st</sup> Century*, HARPER’S BAZAAR, Jan. 2006, at 53-54. Goodwin’s friend received her handbag as a gift from her boyfriend. *Id.* It was also purchased on an Internet website which guaranteed its authenticity. See *id.* Unfortunately, not only was the phony discovered, but the forgery was revealed to her by the actual publicist for the handbag. *Id.* Often, the differences in the counterfeit merchandise and the original are so subtle, only a trained eye can distinguish the two. See *id.* (“My colleague asked her how she could tell and was shown the subtle difference in stitching—almost invisible to the naked eye—that separated her handbag from the genuine thing.”). This is because counterfeiting has become a bigger business and counterfeiters have become more advanced. See *id.* (“Along with Korea and Taiwan, China is now specializing in triple-A mirror-image knockoffs so close to perfect, even the experts have trouble identifying them as fakes.”). While counterfeit artists are getting more advanced, the prior indications of a counterfeit bag no longer hold true, making it more difficult for consumers to discern between goods. One of the “clues” often used to identify a fake is price. See Nellis, *supra* note 2. Interestingly enough, price, while still a significant indicator as to whether or not the bag is counterfeit, is no longer enough. Because of technology and the quality of counterfeit merchandise currently on the market, counterfeit handbags can now be found upwards from \$600, making it easier for sellers to guaranty authenticity and swindle innocent

scenario is more than mere happenstance.<sup>4</sup> Counterfeit and knockoff goods are so prevalent in our society that many have come to accept the man on the corner with the trash bag full of spurious merchandise as the norm.<sup>5</sup> Even the fictional Ugly Betty recently located a fake Gucci and used it to con the

purchasers. In fact, counterfeiters depend on the fact that the higher the price the more likely a consumer is going to believe that their merchandise is real. In an investigation segment, the producers of *20/20* bought six designer bags from five different websites claiming to sell "authentic merchandise." *20/20: Promises, Promises* (ABC television broadcast Jan. 19, 2006). Their purchases ranged in price from \$549 to well over \$1,000. *Id.* All six of the bags purchased were inspected and determined to be counterfeit. *Id.* In the end, the television show spent over \$4,700 for fake merchandise that was claimed to be authentic. *Id.*

4. See *supra* note 3. Jonathan Moss, legal counsel for Gucci in the United States, is quoted as saying: "There isn't a day we don't receive calls from customers complaining that they have purchased products from unscrupulous sellers on websites and received products [that] do not look real or are falling apart . . . . It's the biggest problem by far for us." Goodwin, *supra* note 3, at 53 ("Design houses are constantly plagued by high-end fakes being sold on e-commerce sites. Tiffany & Co. is currently suing eBay, the world's largest auction site, for allowing the sale of counterfeits, and Gucci filed suit against some 30 websites in the United States last year and is currently tackling at least 100 more.").

5. This scenario is one of day-to-day occurrence in places like Los Angeles' Santee Street and New York's Canal Street, where imitation goods are sold by permanent and transient vendors at dramatically reduced prices. See Nellis, *supra* note 2. Although the area is policed with raids and counterfeit sellers face the threat of prosecution, that does not deter buyers from coming in large numbers to purchase counterfeit and knockoff merchandise. See *People v. Rosenthal*, No. 2002NY075570, 2003 WL 23962174 (N.Y. Crim. Ct. Mar. 4, 2003). In New York:

[t]rademark [c]ounterfeiting . . . is punishable by up to one year in jail. It is one of the most frequently charged A misdemeanors in New York County. It may also be the A misdemeanor most often encountered and perhaps openly embraced by law-abiding citizens. A person walking through the streets near the courthouse at 100 Centre Street will find numerous novelty stores and street vendors displaying a vast array of inexpensive pocketbooks, sunglasses, hats, watches, and perfume much of which bears the labels, logos and insignias associated with higher-priced "designer" goods. Even *The New York Times*, in an article in the Travel Section of May 12, 2002, entitled Heading Downtown for Bargains, mentioned the availability of consumer goods of questionable origin as one of the area's leading attractions to visitors.

*Id.* Consequently, counterfeit merchandise is a big business in the United States and across the world, costing American companies \$200 to \$250 billion each year. See Jacqueline Palank, *Congress Considers Fashion's Copyrights*, WASH. TIMES, July 28, 2006, at C10 ("The domestic value of counterfeit goods that U.S. Customs and Border Protection has seized has more than doubled between fiscal 2001 and fiscal 2004 . . . . The domestic value—which is the cost of the seized goods, the cost of shipping and importing the goods and the amount of profit from the goods—jumped from \$57.4 million in fiscal 2001 to \$138.8 million in fiscal 2004."); see also Georgia Sauer, *Shopping Bring Déjà vu? Maybe It's 'Cause Nothing's New*, CHI. TRIB., May 5, 2004, at 4 ("Most people who buy on the streets . . . know it is not the real product and probably would not buy the original anyway. That is not the problem. What they don't realize is that counterfeiting is a crime and distribution of counterfeit goods is a crime. Those manufactures—often in China—do not pay taxes, do not pay just wages, might employ children, and the profits are often linked to various criminal organizations. If you look at the issue from that perspective, it changes everything."); Christine Seib, *Chinese Fakes 'Rising By 1,000%'*, THE TIMES (London), July 24, 2006, at 42 ("[D]esigner goods [are] still the items copied most frequently.").

staff of an elite fashion magazine.<sup>6</sup> I cannot help but wonder: how does this happen, and more importantly, why do we allow it?

Many consider the popular HBO television show “Sex and the City” to be “the biggest pop culture influence on fashion in the past decade” and attribute it with “really giving TV audiences a fashion education.”<sup>7</sup> However, with this “education” has come an obsession.<sup>8</sup> A \$350 billion a-year obsession.<sup>9</sup> Although America has always been conscious of the world of apparel, now “[m]ovies, television shows, the Internet and the media are demystifying fashion, [and] bringing it to the masses.”<sup>10</sup> Even those who

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6. *Ugly Betty: Swag* (ABC television broadcast Jan. 4, 2007). In order to obtain a favor from a fellow assistant at Mode, Betty purchases a fake Gucci handbag and cons the assistant into believing that it is real. *Id.* The chain of events suggests that sometimes even those whose business it is to know such fashions can be fooled by the advancements of counterfeiters. *Ugly Betty* is a current television show on ABC set at an elite fashion magazine. The story centers around the editor in chief’s young, less-than-stylish assistant. The television show is just one example of the public’s current obsession with everything to do with fashion. See Emma Cowing, *Ugly—Or Pretty Smart?*, SCOTSMAN, Jan. 5, 2007, at 10.

7. Ann Oldenburg, *TV Brings High Fashion Down to the Everyday*, USA TODAY, July 12, 2006, at 1A; see also AMY SOHN, *SEX AND THE CITY KISS AND TELL* 67 (Pocket Books 2002) (“If one aspect of the show epitomizes its courageousness and outrageousness, it is the fashion. What began as a whimsical and necessary asset to an already strong series has evolved into a style bible so trendsetting that its influence can be seen all over the country. Items that appear in episodes (a flower on the lapel, Ray-Ban aviator sunglasses, and a nameplate necklace) zoom into popular culture faster than a midtown taxi.”). *Sex and the City* premiered in June 1998 and ran for six seasons. *Id.* The show was on the cutting edge of everything in its conversation: sex, fashion, emotions, and friendship. *Id.* *Sex and the City* won eight Golden Globes and thirty-six additional honors. IMDb, “Sex and the City,” <http://www.imdb.com/title/tt0159206/> (last visited Feb. 1, 2007). The show was nominated for over 125 separate awards during the six seasons that it aired. *Id.*

8. According to the NPD Group market report, spending on clothes has risen seven percent within the last year (from June 2005 to May 2006). Oldenburg, *supra* note 7. Even other sectors of the manufacturing market have latched on to the growing obsession with fashion and have profited from its evolution. See, e.g., Pamela Brill, *Project: Runway*, PLAYTHINGS, Jan. 1, 2007, at 38 (“With so much attention and emphasis devoted to the fashion industry in today’s media, crafts manufacturers say it’s hardly a coincidence that their products have become popular with children increasingly attuned to being stylish and standing out.”). Even websites have joined in on the fun, providing opportunities to those unable to pay the hefty price tag to experiment with high fashion. See I-Dressup, <http://www.i-dressup.com/fashion/> (allowing visitors to mix and match designer fashions on an Internet figure).

9. *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter “Banks”] (testimony of fashion designer Jeffrey Banks).

10. Oldenburg, *supra* note 7. In addition to *Sex and the City* and *Ugly Betty*, television shows such as *Project Runway* (the Bravo reality show centered around a competition involving young fashion designers), *What Not to Wear* (a TLC fashion makeover production), *House of Boateng* (a Sundance Channel reality series focused on Ozwald Boateng’s attempt to open a menswear shop in the United States), and *Access Hollywood* (a television show showcasing designer red-carpet fashions) have contributed tremendously to the national obsession with fashion. *Id.*; see also Bridget Byrne, *As Worn on TV: Reality Shows Bring a Fashion Sense to the Mass Market*, THE RECORD, Feb. 28, 2006, at F7 (“Reality television is turning the fashion world inside out, reshaping it for mass market appeal. These days, fashion programming covers everything from ordinary folks buying pants that fit, to models, makeup artists and designers revealing backstage secrets, and experts advising how to dress like a star on a secretary’s budget.”).

make every effort to avoid making a statement with their fashion<sup>11</sup> are affected by the ever-changing trends and statements of the fashion world.<sup>12</sup> An industry that was once “only for the rich” now allows any innocent bystander to play the fashion game.<sup>13</sup>

Some argue that this democratization has come at the expense of the designers.<sup>14</sup> With the increasing interest in high fashion and recent developments in technology, counterfeit and knockoff artists<sup>15</sup> have reached their peak.<sup>16</sup> Not only are fraudsters able to sell items they recreate on the Web with little overhead or cost,<sup>17</sup> but within minutes of the conclusion of a

11. See Alex Martin, Brown Dress, <http://www.littlebrowndress.com> (last visited Jan. 26, 2007) (a self-proclaimed “one-woman show against fashion”).

12. The following quote is from the 2006 film *The Devil Wears Prada*. For a witty review of the movie, see Kelly Jane Torrance, *Stylish ‘Prada’ Wears Well*, WASH. TIMES, June 30, 2006, at D1. This particular scene involved a young assistant and her boss, the fashion editor of a prominent fashion magazine. It reflects the ideas that many have about the fashion industry, while exemplifying the magnitude of the business and how it affects, in some way, all of our lives.

I see, you think this has nothing to do with you. You go to your closet and you select out, oh I don’t know, that lumpy blue sweater for instance, because you are trying to tell the world that you take yourself too seriously to care about what you put on your back. But what you don’t know is that that sweater is not just blue, it’s not turquoise, it’s not lapis, it’s actually cerulean. You’re also blindly unaware of the fact that in 2002, Oscar de la Renta did a collection of cerulean gowns. And then I think it was Yves St. Laurent, wasn’t it, who showed cerulean military jackets? And then cerulean quickly showed up in the collections of eight different designers. Then it filtered down through the department stores and then trickled on down into some tragic Casual Corner where you, no doubt, fished it out of some clearance bin. However, that blue represents millions of dollars and countless jobs, and so it’s sort of comical how you think that you’ve made a choice that exempts you from the fashion industry when, in fact, you’re wearing the sweater that was selected for you by the people in this room.

THE DEVIL WEARS PRADA (20th Century Fox 2006). The passage of the Design Piracy Prohibition Act, the piece of legislation that is the focus of this Comment, would not only change the face of the fashion world but, in turn, would affect the lives and purchase decisions of individuals across the nation. See discussion *infra* Part V.

13. Oldenburg, *supra* note 7.

14. See Banks, *supra* note 9 (conveying the viewpoint of the fashion designer on the current state of the fashion industry and the problem of design piracy).

15. It is important to note the difference between counterfeit merchandise and “knockoffs.” Counterfeit merchandise actually attempts to pass off non-authentic merchandise as that of the original designer, often by illegally using a designer’s trademark. See Sauer, *supra* note 5, at 4 (“Counterfeiters not only copy the same design as the originals, but they also use the same logos, trying to pass off the fake as original. It’s like forging someone’s signature on a check.”). On the other hand, “knockoffs” are simply less expensive copies of a design, frequently made from more affordable fabric and materials. See discussion *infra* Part III. Under the current intellectual property laws, “knocking-off” a design is perfectly legal and not actionable on any account. See discussion *infra* Part III.

16. See *supra* notes 2-5.

17. Websites such as eBay make it possible for knockoff artists and counterfeiters to sell their merchandise quickly to consumers while reaching potential purchasers across the globe.

runway show exact reproductions of the garments are in the process of being mass produced.<sup>18</sup> Often the replicated designs are obtainable before the original designer has even made his garments available for sale,<sup>19</sup> causing many in the industry to cry out for protection.<sup>20</sup> And while designers have sought protection for their designs before,<sup>21</sup> only now is it starting to look like Congress might be prepared to listen.

Coco Chanel once said, “[f]ashion should slip out of your hands. The very idea of protecting the seasonal arts is childish. One should not bother to protect that which dies the minute it was born.”<sup>22</sup> However, with the introduction of House Resolution 5055 (“H.R. 5055”), members of Congress have proposed to do just that.<sup>23</sup> And while many in the industry are beginning to see the light at the end of the tunnel, the knot has yet to be tied off. There are still those who believe that extending copyright protection will do more harm than good.<sup>24</sup> Vocal opponents to the resolution believe

18. See *infra* notes 65-69 and accompanying text. “It now takes six nanoseconds for a brand to go from class to mass.” Cathy Horyn, *Young Stars of U.S. Fashion Can’t Seem to Find Right Fit*, N.Y. TIMES, Dec. 7, 2002, at A1. A.B.S. by Allen Schwartz, launched in 1982, prides itself on creating “collections that emulated runway trends, which would be delivered to stores so quickly, they beat other major designers to the racks . . . .” A.B.S., Company Profile, [http://www.absstyle.com/asstd\\_pages.php?temp=company](http://www.absstyle.com/asstd_pages.php?temp=company) (last visited Jan. 26, 2007). Schwartz has since created a multi-million dollar company based on knocking-off couture designer fashions. *Id.* He is not the only one. Victor Costa, the “Copycat King,” turned the art of knocking-off other designers’ garments into \$50 million in 1988. Leslie J. Hagin, *A Comparative Analysis of Copyright Laws Applied to Fashion Works: Renewing the Proposal for Folding Fashion Works into the United States Copyright Regime*, 26 TEX. INT’L L.J. 341, 347 (1991) (citing Bonnie Johnson, *Copycat King Victor Costa Cuts the High Costa Designer Duds*, PEOPLE, Aug. 22, 1988, at 96). It is interesting to note that the 2005 publication of i-D’s *Fashion Now*, considered the “Bible of fashion” by *Elle*, did not include either Allen Schwartz or Victor Costa among the “world’s 150 most important designers.” FASHION NOW 3, 7-21 (Terry Jones & Avril Mair ed., TASCHEN 2005) (2003).

19. See Denise Flaim, *Design Inspiration*, NEWSDAY, May 19, 1994, at B47 (“Little more than a month after designers show their fall lines in Milan, Paris and New York, copies are creeping into department stores—sometimes even before the originals that inspired them.”).

20. See Eric Wilson, *O.K., Knockoffs, This is War*, N.Y. TIMES, March 30, 2006, at G1 (“American designers argue that the globalization of fashion needs a different perspective on copycats from their glamorized portrayal . . . .”); see also Banks, *supra* note 9 (conveying the viewpoint of the fashion designer on the current state of the fashion industry and the problem of design piracy). Perhaps fashion designers, like Cher Horowitz, simply want the opportunity to ask, “[w]as that you going through my dirty laundry?” CLUELESS (Paramount Pictures 1995).

21. See discussion *infra* Part IV.

22. Coco Chanel, the doyenne of fashion, revolutionized the fashion industry and, in 1998, was listed as one of the Time 100 Artists & Entertainers. Ingrid Sischy, *Coco Chanel*, TIME, June 8, 1998, at 98 (“She was shrewd, chic and on the cutting edge. The clothes she created changed the way women looked and how they looked at themselves.”). Chanel is largely considered the most influential fashion designer of the twentieth century. See LINDA WATSON, *VOGUE TWENTIETH CENTURY FASHION* 112 (Carlton Books Ltd. 1999).

23. See discussion *infra* Part V.A; see also H.R. 5055, 109th Cong. (2006).

24. See *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter “Sprigman”] (testimony of Christopher Sprigman, associate professor, University of Virginia School of Law) (arguing that protection for fashion design is not needed because: (1) copying does not cause harm to the fashion industry, (2) protection in Europe has had little effect,

that not only will it be nearly impossible to regulate the fashion industry,<sup>25</sup> but they also propose the common consumer will have the most to lose in terms of his ability to purchase garments that, with the imposition of copyright protection, will no longer be financially affordable to him.<sup>26</sup> Which begs the question, when it comes to our obsession with fashion, what should predominate: society's consumerism or the designers' interest in their creative process?

This Comment will explore the current state of protection for fashion designs and the possible and probable consequences of enacting copyright legislation. Additionally, it will pose the question of whether, in a fashion-obsessed world, it is even possible to control an industry that thrives on imitation.<sup>27</sup> Through arguments that support and oppose the resolution, it will become clear that some action is needed, and though it is possible to effectively control the copying of designs, it may not come at a cheap price.

Part II of this Comment will educate on the basics of the fashion business and the creation of fashion designs.<sup>28</sup> Part III will outline the minimal protection currently afforded fashion designs in design patent and trademark.<sup>29</sup> Part IV will discuss the design history pertaining to copyright and why this mode of intellectual property protection is appropriate.<sup>30</sup> Part

and (3) protection will cause excessive litigation); see also *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter "Wolfe"] (testimony of David Wolfe, creative director, The Doneger Group) (arguing that originality of fashion designs could not be determined and that protection would be detrimental to the industry).

25. See Wolfe, *supra* note 24 ("Because it is so difficult to determine what is 'original' about a particular fashion design, it would be equally difficult to enforce a copyright fairly. For example, bestowing copyright to a designer for the 'little black dress,' ubiquitous in the wardrobe of every woman . . . would be unfair because there is no originality in a design for the little black dress. Designer Coco Chanel is credited with introducing the dress in 1926 as a symbol of urban sophistication, and every designer for the past eighty years has copied, reinterpreted, and reintroduced the dress."). See discussion *infra* Part V.B.a.ii.

26. See *infra* notes 220-22 and accompanying text; see also Asher Meir, *Cookrights and Foppyrights*, JERUSALEM POST, Sept. 15, 2006, at 17.

27. Opponents to copyright legislation contend that there is no such thing as originality in the fashion industry. See *infra* note 212. Therefore, protecting original designs would be near impossible. See Suzy Menkes, *RUNWAYS: What's Really New? Watch the Ripples*, N.Y. TIMES, Sept. 17, 1995, at 51 ("[T]he subject of where fashion originates is complex. A search through the archives of fashion history—or even the local thrift shop—could easily produce an A-line dress or a narrow coat from the 1960's that looks just like contemporary Prada. If you blinked your eyes at Gianni Versace's couture show in July, you could have been looking at the space-age creations of Andre Courreges, circa 1964. And for all the fashion force of John Galliano, many of his creations are warmed-over versions of Vionnet's styles from the 30's and haute couture from the 50's.").

28. See *infra* notes 34-73 and accompanying text.

29. See *infra* notes 74-113 and accompanying text.

30. See *infra* notes 114-43 and accompanying text.



V will specifically address House Resolution 5055 and its potential effects—highlighting the economic and artistic effects of providing protection.<sup>31</sup> Part VI will consider possible modifications to the bill,<sup>32</sup> and Part VII will conclude the Comment.<sup>33</sup>

## II. UNDERSTANDING THE FASHION INDUSTRY

On a global level, the fashion industry is responsible for \$750 billion in sales annually.<sup>34</sup> Although the fashion market is international, the majority of creative fashion originates in Europe, Japan, and the United States, where major designers introduce their collections in a series of runway shows each season.<sup>35</sup> Epicenters of design include New York City, Paris, Milan, London, and Tokyo.<sup>36</sup>

However, not all of the fashion industry takes part in Fashion Week<sup>37</sup> or contributes to high fashion in the same way. Fashion, as a business, is composed of approximately twelve different market segments: haute couture,<sup>38</sup> couture,<sup>39</sup> designer,<sup>40</sup> young designer,<sup>41</sup> bridge/better,<sup>42</sup>

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31. See *infra* notes 146-278 and accompanying text.

32. See *infra* notes 279-98 and accompanying text.

33. See *infra* notes 299-308 and accompanying text.

34. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1693 (2006).

35. *Id.* Anywhere from four to six seasonal lines are produced by designers in womenswear. LESLIE DAVIS BURNS & NANCY O. BRYANT, *THE BUSINESS OF FASHION* 140 (Fairchild Publications, Inc. 2002). The lines are then introduced at seasonal runway shows that are held about six months prior to the garments' release in stores. Raustiala & Sprigman, *supra* note 34. The Fall runway shows take place in February and March, and the Spring shows take place in September and October. *Id.*

36. *Id.* While these cities are localized centers of fashion, almost every major city houses a fashion district and hosts fashion shows—even if they showcase only local designers. For example, this spring, Sephora's Fashion Week Live, hosted by models Naomi Campbell and Gemma Ward, is set to bring the high fashion of New York's Fashion Week to Dallas, Houston, San Francisco, and Chicago. See Sephora Fashion Week Live, <http://www.sephora.com/fashionweeklive/>; see also *infra* note 37.

37. Fashion Week is a seasonal industry event that consists of multiple runway shows where designers present their fashions for the upcoming season. See Wikipedia Encyclopedia, [http://en.wikipedia.org/wiki/Fashion\\_Week](http://en.wikipedia.org/wiki/Fashion_Week) (last visited Feb. 1, 2007). It can last anywhere between four days to three weeks. *Id.* Fashion Weeks take place in each major fashion city and are usually named after a sponsor or the city in which they take place. *Id.* Fashion Weeks are attended by members of the industry, retailers, buyers, media, and celebrities. *Id.* Mercedes-Benz Fashion Week, formerly Olympus Fashion Week, hosts seasonal fashion shows in New York City that showcase both established and up-and-coming designers. *Id.* See Mercedes-Benz Fashion Week, <http://www.mbfashionweek.com/newyork/>.

38. See BURNS & BRYANT, *supra* note 35, at 134. Haute couture ("high sewing") is a protected term which is assigned by the *Chambre Syndicale de la Couture Parisienne* to those companies who meet the strict requirements and standards they have set. *Id.* at 135. The *Chambre Syndicale* is composed of designers whose business is called a *house*—i.e. the House of Chanel, the House of Dior, etc. *Id.* Haute couture clothing is the most expensive clothing a buyer can purchase because it is hand-sewn and made to meet the specifications of an individual's body. *Id.* at 134. For couturiers, haute couture lines are generally "financial losing propositions." Jennifer Mencken, *A*

contemporary,<sup>43</sup> junior,<sup>44</sup> upper moderate/lower bridge,<sup>45</sup> moderate,<sup>46</sup> budget,<sup>47</sup> private label,<sup>48</sup> and mass market.<sup>49</sup> Each segment appeals to a different purchaser and possesses its own unique developmental processes. For the purposes of our discussion, all twelve segments fall into one of two

*Design for the Copyright of Fashion*, 1997 B.C. INTEL. PROP. & TECH. F. 121201, 121204 (1997). The haute couture runway show is used to preview the designer's ready-to-wear collection and create an image in the minds of buyers. *Id.* "Designers usually recoup the haute couture losses on the ready-to-wear lines." *Id.*

39. See LINDA TAIN, *PORTFOLIO PRESENTATION FOR FASHION DESIGNERS* 44 (Fairchild Publications, Inc. 2003). Couture is a French term that literally means "sewing" and is generally associated with the European fashion market. *Id.* Customers are usually public figures, socialites, or celebrities, and the garments are made from "fabrics ranging from fifty to hundreds of dollars per yard." *Id.* A single jacket made by a designer such as Oscar de la Renta, Chanel, or Bill Blass usually retails for \$2,500 or more. *Id.*

40. See *id.* The designer segment is usually composed of the ready-to-wear collections of well-known designers such as Donna Karan, Oscar de la Renta, and Calvin Klein, and caters to an affluent customer. *Id.* The clothing design is not trendy and a jacket usually costs \$500-\$1500. *Id.*

41. See *id.* at 45. The young designer segment is composed of both up-and-coming designers and those who have been around a few years, such as Anna Sui, Cat Swanson, Marc Jacobs, and Todd Oldham. *Id.* The design appeals to a trendier customer and the average jacket retails at \$300-\$800. *Id.*

42. See *id.* Bridge/better is sportswear aimed at a broader audience between the ages of twenty and fifty. *Id.* It also includes the secondary lines of designer collections. *Id.* An example of a bridge line is Donna Karan's DKNY. *Id.* A jacket in this segment would retail at \$250-\$425. *Id.*

43. See *id.* Contemporary apparel reaches the widest group and attracts the status-conscious consumer. *Id.* The lines are aimed at purchasers who want a designer look for less, and include A.B.S. and Betsey Johnson. *Id.* The average retail price of a jacket within this segment is \$150-\$225. *Id.*

44. See *id.* The junior segment has quick turn-around and is focused on purchasers starting as young as thirteen. *Id.* It is primarily driven by the denim industry and includes lines such as Guess and Miss Sixty. *Id.* A jacket would range from \$39-\$250. *Id.*

45. See *id.* at 46. Upper moderate/lower bridge is more fashion-forward and more expensive than the moderate segment. *Id.* The lines, including Karen Kane and Jones New York, are aimed at consumers under the age of forty, who are searching for a more forward look. *Id.* The price range for a jacket in this segment is \$100-\$120. *Id.*

46. See *id.* Moderate is aimed at the price-conscious consumer between the ages of fifteen and thirty-five and is mass produced. *Id.* This segment includes jackets ranging from \$70-\$100 and clothing lines such as Rampage and Esprit. *Id.*

47. See *id.* Budget apparel usually consists of promotional merchandise aimed at consumers who are strictly price conscious. *Id.* A budget line would be similar to Bauer or Details and would be sold in department stores or discount stores such as Target or Kmart. *Id.* A jacket in this segment would range from \$50-\$75. *Id.*

48. See *id.* at 46-47. Private label merchandise is manufactured by the store itself and includes lines such as Jaclyn Smith for Kmart and the Saks Fifth Avenue Collection. *Id.* Apparel in this segment covers all markets (from bridge to moderate) and usually costs less than the same item from a branded label. *Id.*

49. See *id.* at 47. Mass market is made up of off-price retailers such as Marshall's, TJ Maxx, and Century 21. *Id.* They offer apparel ranging from designer to budget that is purchased as closeouts from branded manufacturers. *Id.* Mass market makes up roughly ten to twelve percent of women's apparel sales. *Id.*

basic distinct categories: couture or prêt-à-porter.<sup>50</sup> This distinction is noteworthy because the design processes involved in each can be significantly different.

“Couture” generally refers to both haute couture garments that meet the specifications of the *Chambre Syndicale de la Couture Parisienne*,<sup>51</sup> as well as garments that are hand-sewn out of expensive fabrics in order to meet an individual’s exact specifications.<sup>52</sup> The design process for couture garments is analogous to the creation of art. Couturiers create original designs (as opposed to copying), and generally produce a collection composed of several pieces.<sup>53</sup> Following a seasonal<sup>54</sup> runway show, the couturier will take custom orders for specific garments in the collection,<sup>55</sup> since usually only one of each garment exists at the time of the show.<sup>56</sup> From the use of

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50. See BURNS & BRYANT, *supra* note 35, at 136-37. The main distinction between the two categories is the nature of their production and the time and money spent in creating each garment. Couture is hand-sewn and therefore more costly, and prêt-à-porter is mass-produced. See *supra* notes 38-49. Although the two categories are significantly different, designers do not always limit themselves to one category or the other. It is common for couture houses to produce prêt-à-porter collections in addition to their couture collections. See BURNS & BRYANT, *supra* note 35, at 136-37. Prêt-à-porter collections are currently offered by all of the haute couture houses. *Id.*

51. See *id.* at 135. The *Chambre Syndicale de la Couture Parisienne* was formed in France during the early twentieth century in order to provide organizational structure and protection to fashion designers from copyists. *Id.* The association serves to arrange the calendar for the runway shows twice per year, organize accreditation for the press and buyers who would like to attend the shows, and help each design house obtain as much media coverage as possible. *Id.* Currently, there are fewer than thirty haute couture designers who are members of the *Chambre Syndicale*. *Id.* In order to be a member of the *Chambre Syndicale*, designers must comply with strict requirements. First, each house must utilize its own “house” seamstress. *Id.* Additionally, the designer must show at least two collections each year, register all original designs to prevent copying, keep a certain number of models “on staff,” and adhere to the *Chambre Syndicale* calendar. *Id.* The head designer at a fashion house is called the couturier. *Id.* Although other designers consider themselves couture designers, only members of the *Chambre Syndicale* can claim to be within haute couture. *Id.* at 136.

52. See *id.* at 134-37. See *supra* note 38-39.

53. See BURNS & BRYANT, *supra* note 35, at 134-35.

54. See Colin McDowell, *Calendar Girl*, SUNDAY TIMES (U.K.), Oct. 15, 2006, at 33 (explaining the new approach to fashion seasons). Traditionally, fashion shows would occur twice a year (Fall/Winter and Spring/Summer). *Id.* Recently, due to the public’s obsession with purchasing clothes, fashion “seasons” have increased to include at least four collections a year. *Id.* Examples of designer seasonal collections include: Fall/Winter, Holiday, Spring/Summer, and Resort.

55. Couture garments are often ordered after a runway show by a socialite or celebrity. See Sara Gay Forden, *For Designers, Celebrity Mating Ritual*, INT’L HERALD TRIB., May 18, 2006, at 12. In a successful season, the designer may sell fewer than five copies of each garment. The haute couture designs are primarily created to instill an image in the minds of the buyers who will then purchase either one of the designer’s more affordable licensed products or a garment from his ready-to wear collection. See McDowell, *supra* note 54 (explaining how couture shows “are primarily about marketing the name—and that is what sells the bags, the shoes and the make-up colours each season”).

56. See Anamaria Wilson, *The Life of a Dress*, W MAGAZINE, Sept. 2004, at 268-70 (chronicling the life of a designer dress following a runway show). When a dress is a “showstopper,” everyone wants to get their hands on it. *Id.* Keep in mind, there is usually only one copy, and manufactured versions do not hit stores for another six months. *Id.* Following a runway show it is common for a single dress to make it down the red carpet several times (escorted by different celebrities) and into the pages of multiple magazines before the season is complete. *Id.* In the fashion industry, these

expensive fabrics and hand-finishing details, to the time and skill involved in design and putting on a runway show (which includes paying models), creating a couture apparel line is a pricey process, often costing the designer well over \$100,000 before the first order comes in.<sup>57</sup> Understandably, couture garments are the most expensive on the market. The term "couture" is also frequently used in the fashion industry by companies to "impart an elite ambiance to an apparel collection."<sup>58</sup> Although it may be labeled "couture," if a garment is mass-produced and not custom fit for an individual client, the item is not "couture" but is in fact "prêt-a-porter."<sup>59</sup>

Within the arena of prêt-a-porter clothing (or translated into English as "ready-to-wear" clothing),<sup>60</sup> market segments can be distinguished by the quality of design content or the work the designer put into the garment.<sup>61</sup>

runway castoffs are termed "samples." *Id.* With regard to the life of a sample dress and a designer's original creation, designer Michael Kors says he views them "sort of like a baby." *Id.* "We had a skirt from last fall that was beaded with feathers on it, the skirt Nicole Kidman wore to something . . . Then it started going to the trunk shows. Then it went to magazine shoots. By the end of the season, there wasn't a feather left on it." *Id.* In the fashion department of a major fashion magazine, there are times when a sample gown on a photo shoot is needed by another magazine. It is often difficult to work out scheduling with other editors when a magazine has a large shoot and moves over four hundred garments out of New York and into Los Angeles for the week. Four hundred garments, only one copy of each. Understandably, with only one copy, it gets hard for magazines and publicists to share. See discussion *supra* Part I (noting the author's employment at W Magazine).

57. According to designer Diane Von Furstenberg, "Shows are a pain. The expense is so large, and so many times the people who come are irrelevant. [However,] [i]t's tough to beat the system. Ignore it, and you get ignored." Ruth La Ferla, *Who Stole Fashion's Show?*, N.Y. TIMES, Sept. 12, 1999, at 91. Those who continue to put on shows look for ways to reduce the expense of presenting their collection. Corporate sponsorship can make this investment more bearable. See Alicia Drake, *Corporate Sponsors Scramble to Put Their Mark on Fashion*, INT'L HERALD TRIB., March 12, 2001, available at <http://www.ihl.com/articles/2001/03/12/rcorp.t.php#> (last visited Feb. 2, 2007). Even so, newcomers to the fashion industry are not always able to attract big name sponsors to their collections, and often are forced to front the brunt of the expense themselves.

58. See BURNS & BRYANT, *supra* note 35, at 137. The Juicy Couture clothing line is an example of the use of the term "couture" to gain elite status. Although Juicy uses the term "couture" in their name, the collection is not hand-made for individual clients. Rather, the line is mass-produced and sold in department stores across the country, and therefore, is not couture. See *infra* note 59 and accompanying text. According to Gela Nash-Taylor, co-founder of Juicy Couture, the line is all "about wearable, accessible clothing. It is couture for the masses . . . it's really a spoof, it's the opposite of couture." Julie Greenberg, *The Juicy Whirlwind*, WOMEN'S WEAR DAILY, Nov. 15, 2006, at 16B.

59. See *id.*

60. See BURNS & BRYANT, *supra* note 35, at 136-37.

61. See Raustiala & Sprigman, *supra* note 34, at 1693-94 (separating the products in the fashion industry into categories forming a 'fashion pyramid'). "Apparel in the designer categories (couture, designer ready-to-wear, and bridge) is characterized by higher design content and faster design turnover. Generally, apparel in the 'better' and basic categories contain less design content and experience slower design change." *Id.* Therefore, the garments with the most involved design processes are near the top of the design pyramid and are more expensive to create. *Id.*

This distinction usually correlates with the price of the garment, with designer fashions having the most involved design processes and therefore the larger price tag.<sup>62</sup> Designer ready-to-wear collections are often introduced on the runway like couture garments.<sup>63</sup> Additionally, many couturiers develop ready-to-wear collections in addition to their couture collections because prêt-à-porter is where the principal volume of sales exists.<sup>64</sup> Consequently, it is in the realm of ready-to-wear that design piracy predominates, particularly within segments requiring a less-involved design process. The copying of designs is largely due to the ease of mass production techniques and affordable prices, which lessens the amount of time spent on each garment.<sup>65</sup> The time it takes to create a more expensive ready-to-wear garment is more than six times that of mass manufacturers at lower price points, giving pirates significant lead time following a runway show.<sup>66</sup>

An example of how such pirating occurs was outlined in *Johnny Carson Apparel, Inc. v. Zeeman Manufacturing Co.*,<sup>67</sup> where the defendant purchased a suit that had previously gained popularity after considerable

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Manufacturers of apparel toward the bottom of the “fashion pyramid” often keep their prices lower by appropriating designs from more expensive garments, in turn minimizing their design costs. *Id.*

62. See *id.* at 1694 (“One difference between the categories is price; it generally increases as one ascends the [fashion] pyramid.”). See *supra* note 61.

63. See Sylvia Rubin, *New York Fashion Week: Legends and New Blood at Early Runway Shows*, SAN FRAN. CHRON., Sept. 17, 2006, at D6 (detailing the designers and collections present at the September 2006 New York Fashion Week). Because there are so few couture “houses,” the majority of apparel showcased at Fashion Week is the product of designer ready-to-wear collections. See *supra* note 50; see also Mercedes-Benz Fashion Week, <http://www.mbfashionweek.com/newyork/>.

64. See Raustiala & Sprigman, *supra* note 34, at 1694-95 (“Many fashion design firms operate at multiple levels of the pyramid. For example, Giorgio Armani produces couture apparel, a premium ready-to-wear collection marketed via its Giorgio Armani label, differentiated bridge lines marketed via its Armani Collezioni and Emporio Armani brands, and a ‘better clothing’ line distributed in shopping malls via its Armani Exchange brand. Many firms producing high-end apparel have bridge lines, and a growing number of firms have begun to sell their clothing (albeit not exclusively) through their own retail outlets.”). See *supra* note 50.

65. See Patricia Lowell, *Identity Crisis: Less-Expensive Copies of Designer Clothes Are as Old as Fashion Itself*, DALLAS MORNING NEWS, Oct. 5, 1994, at 1E (discussing the prevalence of knockoff designs and their effects on the fashion industry). Knockoff manufacturers have turned the copying of designs into a science, with a turn-around time of merely five days in some cases. *Id.* They use lower-priced fabrics and less-detailed construction techniques in order to create a more affordable version of a designer look. *Id.* “More labor- and time-intensive manufacturing techniques are required to produce fine quality, hand-finished designer clothes, which increases delivery time to as much as three months.” *Id.* Additionally, knockoff manufacturers do not invest in “image management” (i.e. runway shows, high-profile models, etc.) like couture boutiques and avoid costly ad campaigns. *Id.* This lowers the manufacturers’ production costs and allows them to benefit from the advertising and “image management” of the original designer without a monetary investment. *Id.*

66. See *id.* “[L]ag time now is almost nil. Pattern making is computerized. Orders are faxed. And finished garments can be shipped overnight. The speediest manufacturers have whittled turnaround time down to a scant five days for a sample and two weeks for a large shipment.” *Id.*

67. No. C75-544A, 1978 WL 21356 (N.D. Ga. Dec. 20, 1977).

expense and sacrifice by the designer. The swindler created a line-by-line copy of the suit and later returned it for a refund.<sup>68</sup> In some cases, designers for more affordable apparel houses would “[r]ight after the shows at Chanel or Christian Dior . . . run to the nearest sidewalk café and start sketching the collection from memory.”<sup>69</sup> Although these tactics were common practice at one time, improvements in technology mean knockoff artists no longer need to wait for the design to become available before making it their own.<sup>70</sup> With one digital picture the lag time is decreased to near nothing, and computerized pattern-making and order-taking make the process a cinch.<sup>71</sup> In the words of designer Allen Schwartz: “If [you] can put a well-made, great-looking suspender pant in a store for \$190 and it’s sitting 20 feet away from a similar suspender pant by Donna Karan that retails for \$450, which do you think the average consumer is going to want?”<sup>72</sup> Consumers are proving Mr. Schwartz right. Without more safeguards than those currently afforded actual garment *designs*, knockoffs will continue to permeate the market allowing knockoff manufacturers to profit from the investment of the original designer.<sup>73</sup>

68. *Id.*

69. Teri Agins, *Copy Shops: Fashion Knockoffs Hit Stores Before Originals As Designers Seethe*, WALL ST. J., Aug. 8, 1994, at A1. The practice of sending in a mole is still prevalent today. Fashion photographers will discreetly sell copies of runway photos after the conclusion of a runway show. *Id.* There is even such a thing as a “knockoff consultant,” who will travel around taking photos of popular designs inside stores in Europe for knock-off manufacturers. *Id.* On a recent episode of *Ugly Betty*, one of the fashion assistants at the fashion magazine was hired yearly by a knockoff manufacturer to steal the “It” item from the magazine fashion show and deliver it to the manufacturer for copying. *Ugly Betty: I’m Coming Out* (ABC television broadcast Feb. 1, 2007). According to Patricia Lowell, “[s]ometimes the moles are the fashion executives seated in the front row.” Lowell, *supra* note 65.

70. See Agins, *supra* note 69.

71. Lowell, *supra* note 65. This process is simplified thanks to the industry itself. Following a fashion runway show, industry websites such as Style.com will post photos of collections on their sites. See Style.com, <http://www.style.com/fashionshows/> (last visited Feb. 2, 2007); see also Elizabeth Woyke, *Luring Luxury Brands to the Web*, BUS. WK., Sept. 25, 2006, at 116.

72. Lowell, *supra* note 65. Schwartz qualifies his copying of another designer’s garments by claiming that, “[t]he hard-core Donna Karan customer probably won’t even look at an A.B.S. garment, but the majority of American shoppers will look at it and want it and buy it because it gives you the look without the outrageous price.” *Id.* While Schwartz’s observation is likely correct, designers see their designs as a product of their creativity and hard work. When a design is knocked-off, they feel as if something has been taken from them. Consider designer Michael Kors’ statement: “The amount of money and time we spend developing collections is tremendous . . . . [Designers] go through all the aggravation to create even the simplest tank top and then they go out and copy it.” Agins, *supra* note 69. The issue becomes one of economy versus property.

73. Says Patti Cohen of Donna Karan:

It would be interesting if you could take, let’s say, a jacket, and add up the cost of all the time and energy and all the different steps it takes to design it and make it and label it and line it and so on. I think it’s an impossible number to figure out, but that’s what really

### III. FASHION'S CURRENT PROTECTION

Presently, the world of fashion is afforded little protection.<sup>74</sup> Knockoffs are prevalent and perfectly legal,<sup>75</sup> and though the counterfeiting of a designer handbag is technically protected by trademark,<sup>76</sup> this does not prevent the act from occurring.<sup>77</sup> Thus, designers are left with ineffective ways of preventing copying of their work and little recourse in the event of infringement. With copyright protection not yet a part of the equation, patent and trademark law seem, at least in theory, to be the most promising avenues available for protecting designs.<sup>78</sup> In practice, however, the minimal protection provided is proving to be more trouble than it is worth.

#### A. Design Patents

The first design patent statute was enacted in 1842, protecting "useful" designs.<sup>79</sup> However, it was later amended in 1902, replacing "useful" with

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goes into creating a jacket.

Lowell, *supra* note 65. When a knock-off manufacturer copies one of these designs, he benefits from the time and money spent by the original designer to create such a garment.

74. See Anne Theodore Briggs, *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, 24 HASTINGS COMM. & ENT. L.J. 169, 171-200 (2002) (outlining in depth the shortcomings in current intellectual property laws with respect to fashion design).

The distinction between art and design has historically been between fine art and the lesser or useful arts. Sadly, clothing design tends to fall in the latter category and is largely unprotected under United States ("U.S.") law, despite the U.S.' general trend toward longer, stronger intellectual property protection in many other categories.

*Id.* at 170.

75. See *supra* notes 16-18 and accompanying text; see also *People v. Rosenthal*, No. 2002NY075570, 2003 WL 23962174 (N.Y. Crim. Ct. Mar. 4, 2003) ("[W]hile it is perfectly legal to sell merchandise that copies the design and style of a product often referred to as 'knock-offs' it is against the law to sell goods that bear a counterfeit trademark.>").

76. See discussion *infra* Part III.B. A designer who uses a mark to distinguish their product from others in the marketplace may bring a trademark action against any "user of the same or similar mark . . . to prevent further use of the mark and collect money damages for the wrongful use." RICHARD STIM, *PATENT, COPYRIGHT & TRADEMARK* 392 (Nolo 2006) (1996).

77. See *supra* text accompanying notes 2-6.

78. Another avenue of protection argued to be the answer to the design piracy problem is the right of publicity. A discussion and analysis of this area of law is well beyond the scope of this Comment. However, an in-depth analysis of such a proposal can be found at Samantha L. Hetherington, *Fashion Runways Are No Longer the Public Domain: Applying the Common Law Right of Publicity to Haute Couture Fashion Design*, 24 HASTINGS COMM. & ENT. L.J. 43 (2001). In short, Hetherington argues that "[u]nder [the right to publicity], a designer would have a tort action against a design pirate for misappropriation of identity or intrusion on his or her right of publicity, as this is physically expressed in the design and ethos of a couturier garment." *Id.* at 46. While an interesting proposal, it is not likely to address all facets of the fashion industry.

79. WILLIAM H. FRANCIS & ROBERT C. COLLINS, *PATENT LAW* 716 (West Group 2002) (1972). The first design statute made protection available to any new and original design, a printing on fabric, a bust or statue, an impression in marble, a useful pattern, or the shape or configuration of any article. *Id.*

the term “ornamental.”<sup>80</sup> Coincidentally, this is where the problems for apparel began. First, “a design ‘must be the product of aesthetic skill and artistic conception’” in order to be considered “ornamental” and qualify for a design patent.<sup>81</sup> Under this definition the statute could conceptually extend to works of fashion. Nevertheless, such application has proven problematic. For instance, an artistic design may still be rejected as being wholly functional.<sup>82</sup> Therefore, in order to qualify for a design patent, a work must not be the product of “purely functional requirements.”<sup>83</sup> Courts are often unable to separate the useful nature of apparel from its aesthetic components, leaving it outside the definition of protectable material.<sup>84</sup> Additionally, like utility patents, in order to receive a patent an ornamental design must be novel and non-obvious.<sup>85</sup> This requires that the design be

80. *Id.* The current design patent statute is located in 35 U.S.C. §§ 171-73 (2000).

81. FRANCIS & COLLINS, *supra* note 79, at 717 (quoting Hygienic Specialties Co. v. H.G. Salzman, Inc., 302 F.2d 614 (2d Cir. 1962)). “In general, design patents are for ornamental features of an article and are ‘intended to give encouragement to the decorative arts’ contemplating ‘not so much utility as appearance.’” *Id.* (quoting Gorham Mfg. Co. v. White, 81 U.S. 511 (1872)). Therefore, the design must not be dictated solely by a mechanical function. *Id.*

82. “A rejection of a design application as being functional, i.e., dictated by the function to be performed thereby, is only proper when every part or substantially every part of the shape is dictated by the utility to be performed.” *Id.* (quoting *Ex parte Levinn*, 136 U.S.P.Q. 606, 607 (1963)). The wearability of most apparel has made it difficult to separate the utilitarian and aesthetic aspects of a garment in order for it to qualify for a design patent. *See infra* note 84.

83. FRANCIS & COLLINS, *supra* note 79, at 717.

84. *See* *Vanity Fair Mills, Inc. v. Olga Co.*, 510 F.2d 336 (2d Cir. 1975). In *Vanity Fair Mills*, the Olga Company brought a patent infringement claim against Vanity Fair for allegedly infringing its design patents for women’s panty briefs. *Id.* at 337. The Olga Company had created a brief that was able to flatten the abdomen without causing discomfort. *Id.* Vanity Fair adopted an almost identical approach to solving the discomfort problem in the redesign of their brief three years later. *Id.* The design became Vanity Fair’s largest selling brief within a year of its release. *Id.* at 338. Although the district court found the design of the panty brief to meet the patent requirements, the Second Circuit found that the “patents represent[ed] style and comfort improvements rather than an innovative device for stomach control.” *Id.* at 338, 340. In the end, the court determined that “[g]iven the prior art and the availability of assorted stretching materials, a skilled undergarment designer could by some concentrated thinking and experimentation arrive at the same results.” *Id.* at 340. The Olga Company’s patent was not sustained. *Id.* Some courts, although rare, have been able to draw a distinction between the “ornamental” and utilitarian aspects of fashion designs. This result is highly concentrated in cases involving shoes. *See, e.g.,* *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993) (holding that a tennis shoe design was able to meet the specifications required in order to obtain a design patent); *Avia Group Int’l v. L.A. Gear California, Inc.*, 853 F.2d 1557 (Fed. Cir. 1988) (holding that patents for athletic shoes claiming ornamental design were valid and enforceable); *Rockport Co., Inc. v. Deer Stags, Inc.*, 65 F. Supp. 2d 189 (S.D.N.Y. 1999) (holding that a design patent for an ornamental shoe upper was valid and enforceable).

85. FRANCIS & COLLINS, *supra* note 79, at 728. *See* *Gold Seal Importers v. Morris White Fashions, Inc.*, 124 F.2d 141, 142 (2d Cir. 1941) (finding, in the case of a design for a woman’s handbag, “it is not enough for patentability to show that a design is novel, ornamental and pleasing in appearance . . . ‘it must be the product of invention’; that is, the conception of the design must require some exceptional talent beyond the range of the ordinary designer familiar with the prior



“different than any single prior art reference,”<sup>86</sup> as well as not “so related that the appearance of certain ornamental features . . . would suggest application of those features in [another]” work.<sup>87</sup> In the eyes of the courts, fashion is generally not able to meet these criteria.<sup>88</sup>

Even if a garment design could convince courts of its patentability, the patent system is not well geared for use in the world of fashion. In order to receive a patent, a designer would be forced to pay huge sums of money for designs that would likely be out of style before the patent is even issued.<sup>89</sup> In addition, for those designs able to obtain a patent, once issued, the designer would hold a fourteen-year patent for a design with a potential lifespan of only three to six months (one season).<sup>90</sup> Finally, in the rare instance that a design patent is issued and “deemed valid, patent

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art.”). See *infra* notes 86-87.

86. FRANCIS & COLLINS, *supra* note 79, at 728. Essentially, novelty means that “the invention is different from the prior art (that is, all previous products, devices, methods, and documents describing these things). An invention is considered different from the prior art—and therefore novel—when no single prior art item describes all of the invention’s elements.” STIM, *supra* note 76, at 88. If an invention has been within the public domain for over a year without a patent application, it will fail the novelty requirement. *Id.*

87. FRANCIS & COLLINS, *supra* note 79, at 731. “The quality of an obvious invention is such that a person with ordinary skill in the art could reasonably believe that, at the time of its conception, the invention was to be expected.” STIM, *supra* note 76, at 88.

88. See *supra* note 84 (holding that the design of women’s underwear was not capable of obtaining a design patent); see also *H.W. Gossard Co. v. Neatform Co.*, 143 F. Supp. 139 (S.D.N.Y. 1956); *White v. Lombardy Dresses, Inc.*, 40 F. Supp. 216, 218 (S.D.N.Y. 1941) (“[U]nless a higher court decides that a design patent does not require the exercise of the inventive faculty to the extent that the patent law now requires in advancing the particular art, the obtaining of a patent on simply a new and attractive dress is a waste of time.”); *Neufeld-Furst & Co. v. Jay-day Frocks Inc.*, 112 F.2d 715, 716 (2d Cir. 1940) (*per curiam*) (“[I]t is firmly established that more is required for a valid design patent than that the design be new and pleasing enough to catch the trade.”); *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936) (“[N]ew designs are open to all, unless their production demands some salient ability.”); *Belding Heminway Co. v. Future Fashions, Inc.*, 143 F.2d 216, 217 (2d Cir. 1944) (*per curiam*) (“In the absence of evidence that the design, which happened to hit the public fancy, was a wide departure from the past, we should not feel justified in holding the patent valid . . .”).

89. Christine Magdo, *Protecting Works of Fashion from Design Piracy*, LEDA (2000), <http://leda.law.harvard.edu/leda/data/36/MAGDO.html>. (“The Patent and Trademark Office takes an average of eighteen months to review each design patent after application, and then rejects roughly half the applications.”) One design season can last anywhere from three to six months, and many designs are out of style after one season. See *supra* note 54. A design would have to remain popular for over three seasons before it would know the fate of its patent application. Even courts have acknowledged this practical hardship. In *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 190 (S.D.N.Y. 1934), the court noted:

[Although] patent law provides for protection to those who create [clothing] of novel design . . . as a practical matter . . . this fails to give the needed protection, for designs and patterns usually are short-lived and with the conditions and time incidental to obtaining the patent, this protection comes too late, if at all.

90. See Magdo, *supra* note 89. Fourteen years is an unreasonably long time for a designer to monopolize his design. When a specific design is traditionally out of style within three to six months, a fourteen year patent would likely provide the designer the sole right to use that design when it comes back into style ten years later. A lesser protection period is more appropriate for the nature of the fashion industry. See *infra* notes 283-89 and accompanying text.

infringement is found in only about half [of] the cases brought to court.”<sup>91</sup> The entire process poses a wild goose chase for protection that will only be available when it is no longer needed.

### B. Trademark

Because of its duration of protection and lack of a registration requirement,<sup>92</sup> trademark law ostensibly poses the most practical source of intellectual property protection for fashion designers.<sup>93</sup> Still, using trademark law to protect anything more than counterfeit items has proven near impossible.<sup>94</sup>

In its purest form, trademark law exists for the sole purpose of distinguishing products within the marketplace and assisting consumers in

91. See Magdo, *supra* note 89 (citing Richard G. Frenkel, *Intellectual Property in the Balance: Proposals for Improving Industrial Design Protection in the Post-TRIPS Era*, 32 LOY. L.A. L. REV. 531, 555 (1999)). Some courts, while few in number, have been able to separate the utilitarian and aesthetic components of a garment and have allowed patent protection. See *supra* note 84. However, “even if designers secure patent approval in the Patent and Trademark Office, the courts often find design patents invalid.” Magdo, *supra* note 89; see also *US: Ruling Decides Old Dominion’s Quacks Don’t Copy Crocs*, JUST-STYLE, Mar. 1, 2007, <http://www.just-style.com/article.aspx?id=96614> (documenting how “the International Trade Commission (ITC) decided the [Quacks don’t] infringe a design patent of [their] competitor Crocs Inc.”).

92. See Magdo, *supra* note 89; see also STIM, *supra* note 76, at 344-46, 348-50.

93. It has long been argued by legal scholars that trademark law is the most conducive area of intellectual property for providing protection to fashion designs. See S. Priya Bharathi, *There is More Than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667 (1996) (arguing that trademark, and more specifically trade dress, poses the best alternative for combating design piracy in the fashion industry); see also Dorota Niechwiej Clegg, *Aesthetic Functionality Conundrum and Traderight: A Proposal for a Foster Home to an Orphan of Intellectual Property Laws*, 89 IOWA L. REV. 273 (2003) (proposing that the answer to design piracy is found in extending a “traderight” for a limited period of time to creators of a design).

94. See *People v. Rosenthal*, No. 2002NY075570, 2003 WL 23962174, at \*1 (N.Y. Crim. Ct. Mar. 4, 2003) (“The issue presented here can be stated in rather basic terms: when does a low-end, cheaply-made handbag merely look like a high-end, famous-name handbag and when does it actually appropriate the famous-name trademark? The distinction is critical, because while it is perfectly legal to sell merchandise that copies the design and style of a product often referred to as ‘knock-offs’ it is against the law to sell goods that bear a counterfeit trademark.”). Pirates are even able to use a trademark owners’ mark to endorse and promote their product as an exact replication of the original. See, e.g., *Smith v. Chanel, Inc.*, 402 F.2d 562, 572 (9th Cir. 1968) (holding that the use of a trademark owner’s mark to promote a competitor’s similar product does not warrant injunction where the advertisement did all that could be reasonably expected to avoid confusion); *Societe Comptoir de L’Industrie Cotonniere Etablissements Boussac v. Alexander’s Dep’t Stores, Inc.*, 299 F.2d 33, 36 (2d Cir. 1962) (finding that a clothing designer who copied Christian Dior designs would not be enjoined from using the trademark “Dior” in order to promote the garments as long as there was no likelihood of confusion); *Clemens v. Belford, Clark & Co.*, 14 F. 728 (N.D. Ill. 1883) (denying trademark protection to the use of the name “Mark Twain” to promote a book).

accurately identifying the source of goods.<sup>95</sup> This is how fashion designers are able to protect design logos such as the “LV” mark on Louis Vuitton products, making counterfeit goods illegal.<sup>96</sup> While the protection of designer logos protects substantial copying of some forms of apparel and accessories—primarily handbags and accessories<sup>97</sup>—the doctrine of trade dress has the potential to protect replicas of designer apparel without the logo affixed.<sup>98</sup> The reason for this is that trade dress is primarily concerned with product *design* as an indicator of source.<sup>99</sup>

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95. STIM, *supra* note 76, at 340. A trademark can be a brand name, logo, shape, letter, number, sound, smell, or color. *Id.* “Titles, character names, or other distinctive features of movies, television, and radio programs can also serve as trademarks when used to promote a product or service.” *Id.*

96. Another example of a valid trademark is the “Burberry Check,” which “is a trademarked symbol, in this case the distinct plaid pattern that lines its famous raincoats and . . . scarves.” *Rosenthal*, No. 2002NY075570, 2003 WL 23962174, at \*3 (N.Y. Crim. Ct. Mar. 4, 2003). The use of any designer’s trademark, like the “Burberry Check” or “LV,” on a counterfeit product is illegal. *See Chanel, Inc. v. Italian Activewear of Fla., Inc.*, 931 F.2d 1472, 1478 (11th Cir. 1991) (holding that the use of Chanel trademarks on counterfeit goods is infringing); *Gucci Am., Inc. v. Accents*, 955 F. Supp. 279, 284 (S.D.N.Y. 1997) (holding that the trafficking of counterfeit trademarked handbags is in violation of Gucci and Chanel’s trademarks and is therefore enjoined). In a recent advertisement, the designers at Chanel, or perhaps the businessmen who run it, showcased their frustration with the level of protection offered by trademark by printing the following:

A NOTE OF INFORMATION AND ENTREATY TO FASHION EDITORS, ADVERTISERS, COPYWRITERS AND OTHER WELL-INTENTIONED MIS-USERS OF OUR CHANEL NAME. CHANEL was a designer, an extraordinary woman who made a timeless contribution to fashion. CHANEL is a perfume. CHANEL is a modern elegance in couture, ready-to-wear, accessories and other lovely things. Although our style is justly famous, a jacket is not ‘a CHANEL jacket’ unless it is ours, and somebody else’s cardigans are not ‘CHANEL for now.’ And even if we are flattered by such tributes to our fame as ‘Chanel-issime, Chanel-ed, Chanels and Chanel-ized’, PLEASE DON’T. Our lawyers positively detest them. We take our trademark seriously.

Chanel advertisement in *Women’s Wear Daily* (copy on file with the author). *See* Susannah Frankel, *The Name of Coco Chanel*, *THE INDEPENDENT* (London), July 25, 2002, at 11 (comment on the Chanel advertisement).

97. *See* sources cited *supra* note 96. Trademark has also successfully been used to protect the copying of designer jeans. In *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867 (2d Cir. 1986), the Second Circuit found that there was a likelihood of confusion due to similar stitching patterns on the back of a pair of jeans, stating:

[T]he Lanham Act forecloses one jeans manufacturer from using another jeans manufacturer’s distinctive back pocket stitching pattern trademark when the evidence is *undisputed* that the trademark stitching pattern is intimately associated with its owner and the infringing use likely will cause confusion as to the source of the jeans and an unfair shift of goodwill.

*Id.* at 876-77. Therefore, identifiable stitching patterns on current popular designer jeans—such as True Religion, Seven Jeans, and Citizens of Humanity—would likely be protected from infringement under the same theory as that argued in *Lois Sportswear*. However, any design elements associated with those jeans (like wash/coloring, holes, style, etc.) would not be protected from copyists.

98. *See* Bharathi, *supra* note 93 (arguing that trade dress is an alternative to copyright for the protection of fashion design).

99. STIM, *supra* note 76, at 432-33. Under the doctrine of trade dress, “[i]n addition to a label, logo, or other identifying symbol, a product may also come to be identified by its distinctive shape (the Galliano liquor bottle) or packaging (the...Kodak film package). Likewise, a service may be

In order for a product to qualify for trade dress protection, it must be inherently distinctive<sup>100</sup> or acquire secondary meaning,<sup>101</sup> and the use of the trade dress by another manufacturer must cause a likelihood of consumer confusion.<sup>102</sup> In spite of its promise, unlike other intellectual property protection, “trademarks bear no relationship to invention or discovery.”<sup>103</sup> Thus, there is an additional functionality requirement,<sup>104</sup> which means marks

identified by its distinctive décor . . .” *Id.* at 340. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (holding that the décor of a fast-food restaurant was protectable as trade dress). “For example, courts have held that a china pattern, fishing reel design . . . , a television commercial’s theme, and the style of a rock group’s musical performance are all protectable under trade dress.” Bharathi, *supra* note 93, at 1679-80.

100. If a trade dress is inherently distinctive, it does not have to prove secondary meaning in order to receive protection. See *Two Pesos*, 505 U.S. at 776 (“[P]roof of secondary meaning is not required to prevail on a claim under § 43(a) of the Lanham Act where the trade dress at issue is inherently distinctive . . .”). Marks are considered inherently distinctive if “in the context of their use they are memorable—for example, the mark may consist of terms that are arbitrary (Target Stores), suggestive (Jaguar cars), or fanciful (Reebok shoes).” STIM, *supra* note 76, at 374; see also Michele A. Shpetner, *Determining a Proper Test for Inherent Distinctiveness in Trade Dress*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 947 (1998). In *Two Pesos*, the Court held that Taco Cabana’s original restaurant design (trade dress) was inherently distinctive and therefore protectable. *Two Pesos*, 505 U.S. at 776. Practically, this would be a difficult standard for fashion designs to meet, largely because many designers are inspired by similar events, movies, and social movements. See Agins, *supra* note 69 (discussing how “fashion has become increasingly derivative [because] designers all feed at the same trough”).

101. If a trade dress is not inherently distinctive, it must acquire secondary meaning in order to receive trade dress protection. See *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938). In order to acquire secondary meaning, the creator must show that “the primary significance of the term [or trade dress] in the minds of the consuming public is not the product but the producer.” *Id.* at 118. Due to the “style life” of a garment, secondary meaning is not likely to be obtained before a design is either copied or out of style. See Bharathi, *supra* note 93, at 1691. “In a rapidly changing industry, where trends arise almost every season, the length of time required to establish secondary meaning is unlikely to be met.” *Id.*

102. In *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961), the Second Circuit determined that the likelihood of confusion analysis should consider the following factors:

- (1) the strength of the trade dress; (2) the similarity of the trade dress; (3) the competitive proximity of the products; (4) whether the original trade dress owner will bridge the competitive gap existing between the products; (5) whether actual confusion occurred; (6) good faith defenses; (7) the quality of the infringer’s product; and (8) the sophistication of the buyers.

Bharathi, *supra* note 93, at 1685. Even proponents of trade dress protection for fashion design recognize the potential difficulty in finding likelihood of confusion with regard to apparel. See *id.* at 1692 (“[T]he ‘style life’ (usually three months) of a fashion work poses a unique problem not generally faced in other markets.”).

103. JILL GILBERT, *THE ENTREPRENEUR’S GUIDE TO PATENTS, COPYRIGHTS, TRADEMARKS, TRADE SECRETS, & LICENSING* 28 (The Berkeley Publishing Group 2004).

104. See Daniel J. Gifford, *The Interplay of Product Definition, Design and Trade Dress*, 75 MINN. L. REV. 769, 781 (1991) (“A design is functional in the trademark/trade dress context—and hence unprotectable—if the design itself confers competitive advantages upon its user. Thus, if the design is significantly less costly to produce than alternatives, or if the design performs its function

or designs that do provide a function generally must be protected under another body of intellectual property law.<sup>105</sup> Yet again, fashion is forced to face the functionality test, and as usual, it rarely passes.<sup>106</sup> In *Henri Bendel, Inc. v. Sears, Roebuck and Co.*, the court analyzed the components of a private label cosmetic bag and similar bags sold in Sears department stores.<sup>107</sup> The court held that the Bendel bags were not protectable under trade dress laws because the similarities between the bags—the gold zipper, striped design and plastic coated fabric—were all functional.<sup>108</sup> Once more the court was unable to conceptually draw a distinction between the design's aesthetic and functional components.<sup>109</sup>

However, in the 2000 case *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, the Supreme Court made the possibility of trade dress protection for fashion designs virtually unattainable in any case.<sup>110</sup> The Court concluded that a product design would be considered distinctive *only* upon a showing of secondary meaning.<sup>111</sup> In essence, the Court was denying protection to any design that was believed to be inherently distinctive, maintaining that “consumer predisposition to equate the feature with the source does not

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in a markedly superior way to alternative designs, then it is unprotectable. A design that is merely functional in the sense that it performs an intended utilitarian function, but not significantly better than alternative designs, is protectable.”).

105. GILBERT, *supra* note 103, at 28. Owners can typically attempt to protect a functional mark as a part of a product's design under either design patent or copyright. *Id.* However, this is still not an easy task and protection does not always prove to be available. See discussion *supra* Part III.A.

106. See, e.g., *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995) (holding that the manufacturer's sweater designs were not entitled to protection under trade dress because non-functionality could not be established); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995) (finding that the ornamental elements of Knitwaves' sweater designs were functional and not protectable by trade dress); *Fashion Victim, Ltd. v. Sunrise Turquoise, Inc.*, 785 F. Supp. 1302 (N.D. Ill. 1992) (finding that the copying of the idea for plaintiff's “Skeleton Wookiee” shirts did not constitute a trade dress violation); *Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co.*, 292 F. Supp. 2d 535 (S.D.N.Y. 2003) (holding that designer's line of pants were not protectable by trade dress because they lacked a consistent overall look).

107. 25 F. Supp. 2d 198 (S.D.N.Y. 1998).

108. *Id.* at 202.

109. *Id.* (“Bendel's seeks to do precisely what the functionality doctrine was designed to protect against, that is, Bendel's seeks to inhibit legitimate competition by controlling common and useful product features such as stripes, plastic coating, and gold zipper pulls [on cosmetic bags].”).

110. 529 U.S. 205, 216 (2000) (holding that a product's design is only entitled to trade dress protection if it has acquired secondary meaning). See Michele Ingrassia, *A Question of Copycats*, *NEWSDAY*, Jan. 17, 2000, at B6 (discussing the potential impact of the outcome of *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* prior to the Supreme Court's decision). “In an industry in which knockoffs are more plentiful than sequins on a pair of Gucci jeans, the real issue is whether *Wal-Mart vs. Samara Brothers* can help resolve some age-old matters of couture and commerce: Is fashion copycatting illegal?” *Id.* Of course, we know how it turns out. According to *Wal-Mart*, secondary meaning is required in order to obtain trade dress protection. *Wal-Mart*, 529 U.S. at 216. See *supra* note 101 (discussing the difficulty of obtaining secondary meaning for fashion designs). Thus, the playground paradigm “don't copy me” means practically nothing with respect to fashion designs, and pirating is still legal and rampant.

111. *Wal-Mart*, 529 U.S. at 216.

exist.”<sup>112</sup> It has been argued that the Court’s reasoning was incorrect in assuming that design is not indicative of the source, especially with regard to fashion designers “whose success depends on source identification as a result of unique product design.”<sup>113</sup> Nevertheless, this is the state of trade dress protection today, and a safeguard for designs has been ruled out. This lack of patent and trademark protection available for designs has now left fashion designers searching for an alternative way to protect their creative works.

#### IV. THE QUEST FOR COPYRIGHT: THE HISTORY OF FASHION DESIGNS AND THE COPYRIGHT ACT

Designers have argued that the best avenue for protecting fashion designs is copyright, based on its cheap and expeditious application process, the flexibility it provides, and its focus on protecting the labors of artists.<sup>114</sup> Congress has not always agreed.<sup>115</sup> Throughout the years, copyright has continued to evolve. Originally viewed as offering protection solely to

112. *Id.* at 213.

113. Karina K. Terakura, *Insufficiency of Trade Dress Protection: Lack of Guidance for Trade Dress Infringement Litigation in the Fashion Design Industry*, 22 U. HAW. L. REV. 569, 604 (2000). Terakura argues that trade dress does not provide fashion designs with the protection that they need or deserve. *Id.* at 573. She contends that “courts appear oblivious to the importance of the correlation between innovative fashion designs and the identity of the designer.” *Id.* Following an in-depth analysis of *Wal-Mart*, Terakura argues that the reasoning behind the court’s inability to analyze the technicalities of fashion design within trade dress is a lack of guidance. *Id.* at 612. According to Terakura, “[t]he complex branch of potential litigation within the fashion industry is in need of an explicit set of standards established by controlling precedent.” *Id.* at 613. However, some do not believe that protection for clothing is even possible under the current standards for trade dress protection due to their lack of source identification. See Hermenegildo A. Isidro, *The Abercrombie Classifications and Determining the Inherent Distinctiveness of Product Configuration Trade Dress*, 62 BROOK. L. REV. 811, 850 (1996). Consider the following comment:

[P]roduct configurations in certain industries employ uncommon design elements and still do little or nothing to identify the producer. The nature of the product and industry at issue is also important in determining whether a product configuration serves to signify its source. Certain markets are highly dependent on the development of creative and innovative designs. In fact, at the extreme are products whose commercial success is determined largely by the continual introduction of imaginative designs. These include clothing, tableware, furniture and eyewear. It is less likely that the configuration of a product in markets such as these will act as a designator of source.

*Id.*

114. See Safia A. Nurbhai, *Style Piracy Revisited*, 10 J.L. & POL’Y 489, 502-03 (2002) (outlining why copyright protection is the best intellectual property alternative for the fashion industry); see also CHRISTOPHER MAY & SUSAN K. SELL, *INTELLECTUAL PROPERTY RIGHTS: A CRITICAL HISTORY* 9 (Lynne Rienner Publishers, Inc. 2006) (“Unlike patents . . . copyright resides in the work from the moment of creation.”).

115. See *infra* notes 121-26 and accompanying text.

authors,<sup>116</sup> it currently envelops music, film, fine art, and computer software.<sup>117</sup> And though its coverage is usually for expressions of “words, symbols, music, [and] pictures,” its definition also extends to protect “three-dimensional objects” and other non-traditional works of art.<sup>118</sup> However, despite a well-fought battle, fashion has yet to be included within copyright’s reach.<sup>119</sup>

The Constitution of the United States provides Congress with the power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>120</sup> The original Copyright Act, enacted in 1870, granted protection to “painting, drawing, chromo, statue, statuary, and . . . models or designs intended to be perfected as works of the fine

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116. See SIVA VAIDHYANATHAN, COPYRIGHTS AND COPYWRONGS 12-15 (New York University Press 2001) (discussing the evolution of “property talk” and copyright); see also 1 Stat. 124 (1790) (first copyright statute, protecting only maps, charts, and books).

117. For a well-researched history of the evolution of copyright and other intellectual property rights, see MAY & SELL, *supra* note 114 (“Copyright . . . covers literary works (fiction and nonfiction), musical works (of all sorts), artistic works (of two- and three-dimensional form and irrespective of content—from ‘pure art’ and advertising to amateur drawings and your child’s doodles), maps, technical drawings, photography, audiovisual works (including cinematic works, video, and forms of multimedia), and audio recordings.”).

118. *Id.*

119. See *infra* notes 127-35 and accompanying text; see also Rocky Schmidt, Comment, *Designer Law: Fashioning a Remedy for Design Piracy*, 30 UCLA L. REV. 861, 865 n.30 (1982) (listing seventy-four individual bills proposed to protect designs through copyright). Schmidt cites seventy-four design protection bills introduced in Congress prior to 1983: H.R. 2223, 94th Cong. (1975); S. 22, 94th Cong. (1975); S. 1361, 93rd Cong. (1973); S. 1774, 91st Cong. (1969); H.R. 4209, 91st Cong. (1969); H.R. 3089, 91st Cong. (1969); H.R. 7870, 90th Cong. (1967); H.R. 6124, 90th Cong. (1967); H.R. 3542, 90th Cong. (1967); H.R. 2886, 90th Cong. (1967); H.R. 3366, 89th Cong. (1965); H.R. 450, 89th Cong. (1965); S. 1237, 89th Cong. (1965); H.R. 5523, 88th Cong. (1963); H.R. 769, 88th Cong. (1963); H.R. 323, 88th Cong. (1963); S. 776, 88th Cong. (1963); H.R. 6777, 87th Cong. (1961); H.R. 6776, 87th Cong. (1961); S. 1884, 87th Cong. (1961); H.R. 9870, 86th Cong. (1960); H.R. 9525, 86th Cong. (1960); S. 2852, 86th Cong. (1960); S. 2075, 86th Cong. (1959); H.R. 8873, 85th Cong. (1957); H.R. 2860, 80th Cong. (1947); H.R. 5887, 79th Cong. (1946); H.R. 3997, 77th Cong. (1941); H.R. 9703, 76th Cong. (1940); H.R. 6160, 76th Cong. (1939); H.R. 4871, 76th Cong. (1939); H.R. 926, 76th Cong. (1939); S. 2240, 75th Cong. (1937); H.R. 5275, 75th Cong. (1937); H.R. 10632, 74th Cong. (1936); S. 3208, 74th Cong. (1935); S. 3047, 74th Cong. (1935); H.R. 8099, 74th Cong. (1935); H.R. 5859, 74th Cong. (1935); S.J. Res. 120, 73d Cong. (1934) (directing FTC to investigate); S. 3166, 73d Cong. (1934); H.R. 7359, 73d Cong. (1934); H.R. 4115, 73d Cong. (1933); S. 241, 73d Cong. (1933); H.R. 14727, 72d Cong. (1933); S. 5075, 72d Cong. (1932); H.R. 12897, 72d Cong. (1932); H.R. 12528, 72d Cong. (1932); S. 2678, 72d Cong. (1932); H.R. 138, 72d Cong. (1931); H.R. 11852, 71st Cong. (1930); H.R. 7495, 71st Cong. (1929); H.R. 7243, 71st Cong. (1929); S. 3768, 70th Cong. (1928); H.R. 13453, 70th Cong. (1928); H.R. 9358, 70th Cong. (1928); H.R. 13117, 69th Cong. (1926); H.R. 6249, 69th Cong. (1925); H.R. 12306, 68th Cong. (1925); H.R. 10351, 68th Cong. (1924); H.R. 7539, 68th Cong. (1924); S. 2601, 68th Cong. (1924); H.R. 10028, 65th Cong. (1918); H.R. 20842, 64th Cong. (1917); S. 6925, 64th Cong. (1916); H.R. 17290, 64th Cong. (1916); H.R. 14666, 64th Cong. (1916); H.R. 6458, 64th Cong. (1915); S. 3950, 63d Cong. (1914); H.R. 18223, 63d Cong. (1914); H.R. 11321, 63d Cong. (1914); H.R. 20, 97th Cong. (1981); H.R. 4530, 96th Cong. (1979); H.R. 2706, 96th Cong. (1979). *Id.* (citing Memorandum of Points and Authorities in Support of Defendant’s Motion to Dismiss (Appendix A), *Esquire, Inc. v. Ringer*, 414 F. Supp. 939 (D.D.C. 1976)).

120. U.S. CONST., art. I, § 8, cl. 8.

arts . . . .”<sup>121</sup> Nevertheless, it was clear from the beginning that “fine arts” and the definition of copyrightable works did not include “useful articles.”<sup>122</sup> Apparel designs seemingly fell neatly into this latter category, and were therefore not provided protection.<sup>123</sup> Although designers saw a glimmer of hope in the revision of the Act in 1909,<sup>124</sup> it was quickly extinguished by a 1910 copyright regulation excluding the useful arts from protection under the Act.<sup>125</sup> To this day, no copyright protection exists for garments based on their useful nature.<sup>126</sup>

That is not to say that fashion designers have watched the copying of their designs without taking action. In 1935, the Fashion Originators’ Guild of America<sup>127</sup> partnered with members of the industry in order to protect

121. Nurbhai, *supra* note 114, at 494 (quoting Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212 (repealed 1916)).

122. *Id.* See Stuart Jay Young, *Freebooters in Fashions: The Need for Copyright in Textile and Garment Designs*, 9 COPYRIGHT L. SYMP. (ASCAP) 76, 81 (1958). Although “the scope of protection has been steadily widened,” fashion designs have yet to be included within the Act’s definition of copyrightable material. *Id.* at 81-83.

123. Nurbhai, *supra* note 114, at 494. “That garments serve a useful function is indisputable and calls for no discussion.” Young, *supra* note 122, at 83. In his article, Young argues that the “public’s recognition of [clothing designers’] artistic genius” should be enough to resolve the “questions of aesthetic values.” *Id.* Still, the idea of clothing design as an art form is difficult for legislators and courts to comprehend. See discussion *infra* Part V.B.1.b.

124. In the 1909 revision of the Copyright Act, the term “fine” was dropped from the phrase “fine arts.” Nurbhai, *supra* note 114, at 494-95. This led some to believe that useful articles could gain protection under the revised Act. *Id.* The deletion was viewed as “a blurring of ‘the line of demarcation between purely aesthetic articles and useful works of art.’” Young, *supra* note 122, at 81 (quoting Richard W. Pogue, *Borderland—Where Copyright and Design Patent Meet*, 6 COPYRIGHT L. SYMP. 16 (ASCAP) (1955)).

125. The copyright regulation provided:

Works of art—This term includes all works belonging fairly to the so-called fine arts. (Paintings, drawings, and sculpture).

Productions of the industrial arts utilitarian in purpose and character are not subject to copyright registration, even if artistically made or ornamented.

No copyright exists in toys, games, dolls, advertising, novelties, *garments*, laces, woven fabrics, or any similar articles.

Nurbhai, *supra* note 114, at 495 (emphasis added) (citing Young, *supra* note 122).

126. See *id.* at 494-501 (outlining the history of copyright protection pertaining to fashion designs).

127. See Sara B. Marcketti & Jean L. Parsons, *Design Piracy and Self-Regulation: The Fashion Originators’ Guild of America, 1932-1941*, 24 CLOTHING & TEXTILES RES. J. 214, 215 (2006) (examining “the ethical, economic, and social considerations in arguments for and against design protection and [analyzing] the role of designers, manufacturers, retailers, and consumers in the initial success and ultimately the failure of the FOGA”). The Fashion Originators’ Guild of America (“FOGA”) was incorporated in March of 1932 by designer Maurice Rentner. *Id.* at 218. The organization was “built on a foundation of retailer-manufacturer collaboration in a movement to protect and popularize original styles.” *Id.* The FOGA implemented advertising and promotional campaigns in newspapers and trade magazines, created a registration bureau for creators of original designs, and issued labels for identification of original designs. *Id.* “The guild estimated that



designers from design piracy.<sup>128</sup> Each member of the association pledged to refuse to sell copied creations and signed a “declaration of cooperation.”<sup>129</sup> The practice worked largely because members were forbidden to deal with “non-cooperating” retailers.<sup>130</sup> Doing business with a retailer who had failed to cooperate would subject any other dealer to large fines.<sup>131</sup>

For awhile, the effort was immensely successful. At the peak of its existence, the Guild controlled sixty percent of the market for women’s clothes in the higher-end market, and thirty-eight percent of those at a lower price point.<sup>132</sup> But all good things come to an end. It was not long before the Guild was attacked for violation of the Sherman Anti-Trust Act.<sup>133</sup> Following the Supreme Court’s decision on the case in 1941,<sup>134</sup> the Guild was shut down and the fashion industry was left in the dark yet again. Soon after, a league of women’s hat designers engaged in similar tactics was also shut down.<sup>135</sup>

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members and affiliates registered 40,000 to 50,000 styles a year and about half of these styles were in the [higher-end] price range.” *Id.* at 219.

128. Nurbhai, *supra* note 114, at 495.

An extensive design registration bureau containing the designs registered by the Guild members was maintained. The [red] cards were sent to all members from time to time bearing on their face, the name of a “non-cooperating” retailer. Henceforth all other members of the Guild were forbidden to deal with that retailer under penalty of large fines.

*Id.* at 496 n.52 (quoting Young, *supra* note 122, at 107).

129. *Id.* at 495. In the “declaration of cooperation,” the members of the Guild agreed to deal only in original creations subject to penalty if they were to violate their pledge. *Id.* at 495-96. “These signed agreements included clauses that retailers would not knowingly or intentionally purchase copied merchandise and that the retailer would return to the manufacturer any copies bought through misrepresentation or error.” Marcketti & Parsons, *supra* note 127, at 220.

130. Nurbhai, *supra* note 114, at 496.

131. *Id.*

132. *Id.* “By 1936, manufacturer membership in the guild numbered approximately 200 to 250, and retailer cooperation numbered 12,000 to 12,500 individuals, copartners, and corporations, located throughout 32 states in the United States, but principally in New York City, Chicago, and Boston.” Marcketti & Parsons, *supra* note 127, at 220.

133. Nurbhai, *supra* note 114, at 496. See *Fashion Originators’ Guild of America, Inc. v. Fed. Trade Comm’n*, 312 U.S. 457, 460 (1941) (ordering the dissolution of the Fashion Originators’ Guild of America for “practices . . . done in combination and to constitute ‘unfair methods of competition’ tending to monopoly”). The Court found the FOGA in violation of the Sherman Act because it had “pursuant to understandings, arrangements, agreements, combinations and conspiracies entered into jointly and severally had prevented sales in interstate commerce, had substantially lessened, hindered and suppressed competition, and had tended to create in themselves a monopoly.” *Id.* at 464 (internal quotations omitted).

134. *Fashion Originators’ Guild*, 312 U.S. at 468.

135. Raustiala & Sprigman, *supra* note 34, at 1697-98. The Second Circuit acknowledged the need for the guilds but determined that the FTC was warranted in shutting them down:

What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted. An “original” creation is too slight a modification of a known idea to justify the grant by the government of a monopoly to the creator; yet such are the whims and cycles of fashion that the slight modification is of great commercial value. The creator who maintains a large staff of highly paid designers can recoup his investment only by selling the hats they design. He suffers a real loss when the design is copied as soon as it appears; the imitator in turn reaps a substantial gain by appropriating for himself the style innovations produced by the

The Copyright Act continued to face modification, but it rarely considered protection for fashion designers among its improvements. In 1949 members of the industry found hope when the Copyright Office revised the definition of “works of art” and broadened the scope of articles that could be copyrighted.<sup>136</sup> It was quickly dashed when the Office instead “took the position that fashion’s dominant function is utilitarian.”<sup>137</sup> “Although apparel works emphasize style and appearance instead of utility,”<sup>138</sup> in accordance with prior legislation, the 1976 amendments to the Copyright Act continued to label garments as utilitarian and failed to consider them protectable works.<sup>139</sup>

Over the years the Copyright Act has undergone significant changes in the world of ornamental designs and useful articles.<sup>140</sup> Such examples include the Digital Millennium Copyright Act<sup>141</sup> and the extension of design protection to boat hulls.<sup>142</sup> Fashion designers have long hoped to build on this progress by adding people of their ilk to the list of those afforded the right to their original expression. As Andy Dufresne once said, “hope is a good thing . . . and no good thing ever dies.”<sup>143</sup> The first part of this statement was proven true on May 30, 2006, with the introduction of a new bill in the House of Representatives.<sup>144</sup> Whether that bill lives or dies,

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creator’s investment. Yet the imitator may copy with impunity, and the law grants no remedy to the creator.

*Id.* at 1698 (citing *Millinery Creators’ Guild v. FTC*, 109 F.2d 175, 177 (2d. Cir. 1940)).

136. Nurbhai, *supra* note 114, at 496-97. The 1949 amendment defines works of art as follows: “This class includes works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.” *Id.* at 496 (quoting 37 C.F.R. § 202.8(a) (1952)).

137. *Id.* at 497.

138. *Id.* at 500. “[E]ven though competitiveness turns on originality in the fashion industry, the doctrine of conceptual separability does not provide copyright protection for apparel.” *Id.*

139. *Id.*

140. *Id.* at 500-01. Congress has significantly broadened the scope of the Copyright Act with respect to useful articles. *Id.* Because of this “movement” in intellectual property protection, H.R. 5055 stands a chance of making it although previous design bills have failed. *See supra* note 119.

141. Nurbhai, *supra* note 114, at 501 (citing H.R. Res. 2281, *reprinted in* 144 CONG. REC. H10, 048-64 (daily ed. Oct. 8, 1998)). Another example is the Semiconductor Chip Protection Act of 1984. *See* JON A. BAUMGARTEN, *THE SEMICONDUCTOR CHIP PROTECTION ACT OF 1984* (Law & Business, Inc. 1984) (outlining the provisions of the Semiconductor Chip Protection Act). Legislation such as this served as an indicator that Congress was willing to consider expanding the definition of copyright to include certain articles that were primarily utilitarian in nature.

142. *See* 17 U.S.C. §§ 1301-32 (2000). The extension of copyright protection to boat hulls, which are inherently utilitarian in nature, is the basis for the proposal of protection for fashion designs. *See supra* note 145.

143. *THE SHAWSHANK REDEMPTION* (Sony Pictures 1994).

144. *See infra* notes 145-55 and accompanying text.

however, remains to be seen. This Comment will now turn its attention towards understanding this important piece of legislation and its chances for survival.

## V. THE DESIGN PIRACY PROHIBITION ACT

### A. House Resolution 5055<sup>145</sup>

House Resolution 5055 (“H.R. 5055”)—popularly titled the Design Piracy Prohibition Act—proposes to eliminate the “design piracy” problem by extending copyright protection to fashion designs under 17 U.S.C. § 1301.<sup>146</sup> The legislation, introduced by House Representative Bob Goodlatte,<sup>147</sup> would “prevent anyone from copying an original clothing design in the United States and give designers the exclusive right to make, import, distribute, and sell clothes based on their designs.”<sup>148</sup> Although the

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145. This Comment focuses on the original Design Piracy Prohibition Bill introduced to the 109th Congress in 2006. *See* H.R. 5055, 109th Cong. (2006). However, an exact replica of H.R. 5055 was reintroduced into the House of Representatives by Representative William Delahunt of Massachusetts on April 25, 2007. *See* H.R. 2033, 110th Cong. (2007). The bill before the current 110th Congress is known as H.R. 2033. *See id.* The reintroduction of the Design Piracy Prohibition Act evidences Congress’ concern with the fashion industry and the prolific piracy problem in the United States.

146. *See* H.R. 5055, 109th Cong. (2006); *see also* James D. Nguyen & Heidi L. Belongia, *Copyright In Vogue: The Proposed “Design Piracy Prohibition Act,”* MONDAQ, Nov. 28, 2006 (summarizing the need for and provisions of the proposed legislation). The current reading of § 1301, enacted in 1998, affords copyright protection to boat hulls. 17 U.S.C. § 1301 (2000). The relevance of the statute is that it has managed to circumvent the “useful article” exception to copyright law by merely avoiding the issue. *See id.* Consequently, Chapter 13 merely acts as an extension of copyright by offering design protection only to designs listed in the chapter which meet its requirements. *See id.* Currently, boat hulls are the only designs covered. *See id.* House Resolution 5055 hopes to ride on the ground gained by Chapter 13 and continue to avoid the “useful article” problem by merely adding apparel to the list of designs protected by the statute. *See* H.R. 5055, 109th Cong. (2006).

147. Congressman Bob Goodlatte is a Republican currently in his eighth term representing Virginia’s Sixth Congressional District. *See* United States House of Representatives, <http://www.house.gov/goodlatte/> (last visited Jan. 18, 2007). Representative Goodlatte is a graduate of Washington and Lee University School of Law and has spent a considerable amount of his time in Congress on Internet and high-tech issues. *Id.*

148. Henry Lanman, *Copycatfight: The Rag Trade’s Fashionably Late Arrival To The Copyright Party*, SLATE, Mar. 13, 2006, <http://www.slate.com/id/2137954/>. In his article, Lanman discusses the resolution and the reasons the Council of Fashion Designers of America (“CFDA”), alongside other supporters, believe such legislation is necessary. *Id.*

The gap the CFDA is trying to fill is there because existing copyright law protects only original or creative expressions. Generally speaking, this has precluded coverage for “useful articles,” which essentially means anything with a utilitarian purpose. Courts have traditionally insisted on seeing clothing as a “useful article” unprotected by copyright, at least in part out of fear that to do otherwise would be to create style “monopolies” that would chill creativity and increase prices.

*Id.* *See* discussion *supra* Part III.

resolution has garnered support from both Democrats and Republicans,<sup>149</sup> as well as law professors<sup>150</sup> and fashion designers,<sup>151</sup> there are still many who are yet to be persuaded of the social and economic benefits to such legislation.<sup>152</sup> The Copyright Office serves as an example of those who believe that “there may well be merit to the view that fashion designs should be given protection . . . but [does] not believe [they have] thus far been presented with sufficient information to reach a conclusion on the need for such legislation.”<sup>153</sup> In addition to groups in need of convincing, actual

149. As of this writing, the bill has seven cosponsors (three Democrats and four Republicans). H.R. 5055 was supported by Republican Representatives Howard Coble of North Carolina (original cosponsor), James Sensenbrenner of Wisconsin (added April 6, 2006), Mary Bono of California (added April 25, 2006), and Christopher Shays of Connecticut (added September 29, 2006). The Democratic cosponsors are Representatives William Delahunt of Massachusetts (original cosponsor), Robert Wexler of Florida (original cosponsor), and Carolyn Maloney of New York (added May 10, 2006). The Library of Congress, H.R. 5055—Cosponsors, <http://thomas.loc.gov/cgi-bin/bdquery/z?d109:HR05055:@@P>.

150. Susan Scafidi, a visiting professor at Fordham Law School, testified in front of the 109th Congress in support of the adoption of H.R. 5055 on July 27, 2006. See *Design Piracy Prohibition Act: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter “Scafidi”] (written statement of Susan Scafidi, visiting professor, Fordham Law School) (discussing the current changes in the economy and the need for protection for fashion designs under the copyright act). Professor Scafidi also maintains a fashion design piracy website where she documents and comments on the current issues facing the fashion industry with respect to intellectual property. See Counterfeit Chic, <http://counterfeitchic.com>.

151. The bill is supported in large part by the Council of Fashion Designers of America, as well as the French Federation of Haute Couture, Ready to Wear & Designers, and the National Chamber for Italian Fashion. Elizabeth Woyke, *Fashion's Bid to Knock Out Knockoffs*, BUS. WK., Apr. 10, 2006, at 16. The CFDA is currently made up of over 300 American fashion and accessory designers. Council of Fashion Designers of America, <http://www.cfda.com/flash.html> (last visited Jan. 18, 2007). Noted designers who are members of the CFDA are Brian Atwood, Michael Kors, Anna Sui, and Carmen Marc Valvo. *Id.* Furthermore, fashion designer Jeffrey Banks also made an appearance before Congress in order to render his support to the adoption of the Act. See Banks, *supra* note 9. It is important to note, however, that not all fashion designers are necessarily in approval of H.R. 5055. In a recent forum on the evolution of fashion, designer and CFDA member Tom Ford concurred with *New York Times* style reporter Guy Trebay when he noted that “[t]here’d be no fashion” if the fashion industry had to obey the copyright laws. Videotape: The Ecology of Creativity in Fashion (Norman Lear Center 2005), available at <http://www.learcenter.org/html/projects/?&cm=ccc/fashionsched>.

152. Christopher Sprigman, associate professor at the University of Virginia School of Law, testified as to the lack of a need for such legislation and stated that the “primary effect of H.R. 5055 will be extensive and costly litigation over what constitutes infringement.” Sprigman, *supra* note 24. Additionally, a few members of the fashion industry, such as David Wolfe who is the creative director of the Doneger Group, have also spoken out against the legislation stating that “[b]ecause it is so difficult to determine what is ‘original’ about a particular fashion design, it would be equally difficult to enforce a copyright fairly.” Wolfe, *supra* note 24.

153. *Protection for Fashion Design: Hearing Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. (2006) [hereinafter “Copyright Office”] (statement of the United States Copyright Office).

opponent arguments against the resolution range from economic concerns<sup>154</sup> to those who believe fashion is merely not within the definition of creative expression copyright was meant to cover.<sup>155</sup> However, in order to discuss the arguments for and against the legislation, it is important to understand what Congress is proposing.

## 1. Provisions of the Proposal

H.R. 5055 attempts to build on the 1998 design protection statute providing copyright protection to boat hulls.<sup>156</sup> According to the Copyright Office, “the statute was written in such a way that it could later be amended to cover designs of useful articles in general, simply by revising the statutory definition of ‘useful article’ to reflect the plain meaning of that term.”<sup>157</sup> By adding fashion design to § 1301, the Act would effectively extend current copyright protection to *original* “undergarments, outerwear, gloves,

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154. See Raustiala & Sprigman, *supra* note 34, at 1732-34 (summarizing the economic benefits to affording little IP protection to fashion designs and the need for copying to sell fashion). “Our point is simply that the existence of identifiable trends is itself a product of pervasive design copying and that the creation and accelerated extinction of these trends helps to sell fashion.” *Id.* at 1733. See discussion *infra* Part V.B.1.c.

155. See Bharathi, *supra* note 93, at 1679 (“[L]egislators and courts have a great deal of trouble seeing past the utilitarian function of a piece of clothing.”). See discussion *infra* Part V.B.1.b.

156. “Chapter 13 is written in the form of a general design protection statute offering protection to ‘an original design of a useful article which makes the article attractive or distinctive in appearance to the purchasing or using public.’” Copyright Office, *supra* note 153 (quoting 17 U.S.C. § 1301(a)(1)). Prior to 1998, boat hulls would not have been copyrightable due to their utilitarian purpose. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). However, following the 1989 Supreme Court case *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), Congress was forced to take a second look at the Copyright Act. In *Bonito Boats*, the Supreme Court addressed a Florida state statute protecting the design of boat hulls. *Id.* at 144. The specific problem this statute addressed was “hull splashing.” Copyright Office, *supra* note 153. This occurs when a manufacture invests large amounts of time and money into research and the development of a design for one line of boats. *Id.* During this process the manufacturer develops a boat mold to create the whole line. *Id.* However, other manufacturers, such as Thundercraft in this case, simply make a mold directly from a completed boat hull and then create their own line without investing time or money into the development of the project. *Id.* The Supreme Court found that the Florida statute illegalizing such behavior was unconstitutional. *Bonito Boats*, 489 U.S. at 168. The basis for the Court’s holding was that the state statute interfered with federal regulation of intellectual property and was preempted by the Supremacy Clause. *Id.* at 157-68. The Court felt that “[i]t is for Congress to determine if the present system of [intellectual property protection] is ineffectual in promoting the useful arts . . . .” *Id.* at 168. And soon after the *Bonito Boats* decision, Congress did just that. In 1998, Congress enacted Chapter 13 of the United States Code, providing protection to original designs. See 17 U.S.C. §§ 1301-32 (2000). However, the only original design currently covered by the legislation is that of boat hulls. 17 U.S.C. § 1301 (2000).

157. Copyright Office, *supra* note 153. This ostensibly poses the most reasonable approach to adding the fashion industry to the list of those protected by the Copyright Act. The additions proposed by H.R. 5055 are minimal and, with a few modifications, could be easily included within the definition of copyrightable works. See discussion *infra* Part VI. Although design protection statutes have had little success in the past, H.R. 5055 is the first design bill proposed since Congress enacted Chapter 13 of the United States Code. See *supra* note 119.

footwear, and headgear,” in addition to *original* “handbags, purses, . . . tote bags[,] belts, and eyeglass frames.”<sup>158</sup> Therefore, much of the same protection provided to boat hulls under Chapter 13 would be afforded to apparel with few significant changes.<sup>159</sup>

Like boat hulls, a fashion design would be considered “original,” and thus protectable, “if it is the result of the designer’s creative endeavor that provides a distinguishable variation over prior work pertaining to similar articles which is more than merely trivial and has not been copied from another source.”<sup>160</sup> Any design that is not considered original, is considered a staple or commonplace, is only insignificantly different from staple designs, or is dictated solely by utilitarian function, would not be protected by the resolution.<sup>161</sup> While there is no clear definition of what would constitute “originality” in the world of fashion, many assume that the Act

158. H.R. 5055, 109th Cong. (2006).

159. See 17 U.S.C. §§ 1301-32 (2000). The only major change in protection is the amendment of Section 1309 by the addition of subsection (h), which reads:

Secondary Liability. The doctrines of secondary infringement and secondary liability that are applied in actions under chapter 5 of this title apply to the same extent to actions under this chapter. Any person who is liable under either such doctrine under this chapter is subject to all the remedies provided under this chapter, including those attributable to any underlying or resulting infringement.

H.R. 5055, 109th Cong. (2006). According to the U.S. Copyright Office’s report to Congress, this section of the resolution was largely added in response to websites that offer detailed photographs of fashion designs immediately following a designer’s runway show. See Copyright Office, *supra* note 153. These websites are known to charge subscription fees for their services to their subscribers, who are largely made up of knockoff manufacturers. *Id.* According to the report, earlier drafts of the resolution provided for liability for such websites by making the publishing of those photographs infringing. *Id.* The Copyright Office, however, cautioned against such an addition to the legislation with First Amendment concerns, and instead, proposed the addition of the doctrine of secondary liability. *Id.* The subsection extends the doctrines of secondary liability addressed in *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005), to all designs protected under Chapter 13. *Id.*

160. 17 U.S.C. § 1301(b)(1) (2000). This is where many opposed to the passage of H.R. 5055 take issue. Their primary concern is with the determination of the “originality” of a design in an industry that thrives on taking ideas from the past and turning them into tomorrow’s fashion. See Wolfe, *supra* note 24. Being “inspired” by other designers is considered a part of the trade, and some question the courts’ ability to draw a line between what is original and just “inspired” by another design and what is considered a copy for purposes of infringement. *Id.* The U.S. Copyright Office, in their statement to Congress concerning design protection, asked to “[clarify] that the Office does not make judgments as to whether a particular design is sufficiently original or distinctive to qualify for protection.” Copyright Office, *supra* note 153. See discussion *infra* Part V.B.1.a.ii.

161. 17 U.S.C. § 1302 (2000). This would eliminate the ability to copyright such things as the standard white T-Shirt, the use of a common color, or a simple design. Garments that are already a part of the public domain would also be outside the scope of the Copyright Act.

would primarily be used by designers of haute couture and garments priced in the thousand dollar range.<sup>162</sup>

However, just being deemed an “original” design would not be enough to warrant protection under the proposed bill.<sup>163</sup> In addition to the originality requirement, a copyright application<sup>164</sup> must be filed within three months of publication<sup>165</sup> by the designer or owner of the design.<sup>166</sup> If the application is deemed sufficient by the Copyright Office, a registration certificate granting protection, including a drawing of the protected design, would be issued to the designer.<sup>167</sup> For those who are denied registration, however, this is not the end of the road. The appeal process for fashion designs would be the same as the process for boat hulls.<sup>168</sup> Thus, if the application is refused, within three months of the refusal the copyright applicant may file a written appeal of reconsideration.<sup>169</sup> If the denial of registration is upheld, the applicant may then seek judicial review.<sup>170</sup>

For those creations lucky enough to be deemed “original,” once registered, the fashion design would garner copyright protection for a stint of three years.<sup>171</sup> While this is much shorter than the time provided for other

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162. See *supra* notes 38-39. Consider this statement by the United States Copyright Office: “[T]he purpose of the legislation is to protect designs of *haute couture* during the period of time in which such high-end clothing is sold at premium prices . . . and to prevent others from marketing clothing with those designs at substantially lower prices during that initial period, thereby undercutting the market . . .” Copyright Office, *supra* note 153. This Comment proposes a more precise definition of the term “original” than that currently included in the resolution. See *infra* notes 280-82 and accompanying text.

163. H.R. 5055 § 1(e)(1), 109th Cong. (2006).

164. The requirements of the copyright application are covered by § 1310 of the Code. 17 U.S.C. § 1310 (2000). The application, which includes a sworn statement affirming the originality of the design, may be filed by either the designer or the owner of the design. *Id.* The application, among other things, must include the date of publication, the specific name of the article, affirmation that the design is connected with the useful article, and any “other information as may be required by the Administrator.” *Id.*

165. H.R. 5055 uses the same definition for publication as that used for boat hulls. “A design is made public when an existing useful article embodying the design is anywhere publicly exhibited, publicly distributed, or offered for individual or public sale or sold to the public by the owner of the design or with the owner’s consent.” H.R. 5055 § 1(e)(2), 109th Cong. (2006); see also 17 U.S.C. § 1310(b) (2000). In the fashion world, the use of an article in a fashion magazine, a runway show, or an appearance on a red carpet would be enough to constitute publication. Therefore, following this initial debut, the designer would have no more than three months to file a copyright application before their design would become a part of the public domain. H.R. 5055 § 1(e)(2), 109th Cong. (2006).

166. H.R. 5055 § 1(e)(1), 109th Cong. (2006).

167. 17 U.S.C. § 1314 (2000). The drawings included in the registration certificate are reproductions of the drawings or other pictorial representations that were included in the application for registration. *Id.*

168. Compare 17 U.S.C. § 1313 (2000), with H.R. 5055, 109th Cong. (2006).

169. 17 U.S.C. § 1313(b) (2000).

170. 17 U.S.C. § 1321(b) (2000).

171. H.R. 5055 § 1(c), 109th Cong. (2006). It has been argued that “[t]his period will allow designers time to develop their ideas . . . prior to displaying the work to the general public, followed by a year of exclusive sales as part of the designer’s experimental signature line, and another year to

copyrightable works,<sup>172</sup> it is still a bone of contention for those who are against the proposal.<sup>173</sup> Even so, the Copyright Office has found the “modest” term appropriate and “calibrated to address the period of time during which fashion designs are most at risk of being infringed and . . . designers are most likely [to] be harmed by the sale of infringing goods.”<sup>174</sup> As for those who consider the term too lengthy, consider the quote of former fashion designer Elizabeth Hawes: “Any dress which isn’t in style for at least three years isn’t any good to begin with.”<sup>175</sup>

## 2. Infringement

Receiving copyright protection covers only one aspect of H.R. 5055. With protection comes violation, and repercussions soon to follow. Accordingly, once the fashion design has achieved its copyright, it would be an act of infringement for anyone to make, sell, or import any article where “the design . . . has been copied from a design . . . protected under [§ 1301], without the consent of the owner of the protected design.”<sup>176</sup> And like other acts of infringement, this could be a costly matter. The proposal provides

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develop diffusion lines or other mass-market sales.” Scafidi, *supra* note 150. However, this Comment suggests a shorter protection period for alternate reasons. See *infra* notes 283-89 and accompanying text.

172. For example, the copyright extended to boat hulls under the same chapter is for a term of ten years. 17 U.S.C. § 1305(a) (2000). Authors are provided protection for the length of their life plus fifty years. See VAIDHYANATHAN, *supra* note 116, at 25 (outlining the history of copyright protection terms provided to authors). Although shorter, the period of protection proposed by H.R. 5055 was selected based on the fast-paced nature of the fashion industry.

173. See Wilson, *supra* note 20 (claiming that A.B.S. “would be restricted to selling copies of the embroidered beige Elie Saab gown worn by Halle Berry in 2003, not the latest Vera Wang yellow butterfly ruffles for Michelle Williams”). Although “knock-off” designers would not be privy to the most recent haute couture creations, the three-year time period does provide an opportunity for the designer to market their garment and create a ready-to-wear line that would likely serve the same niche market that A.B.S. does. The only difference would be that the designer would be using his own original creation, as opposed to appropriating the ideas of others like Allen Schwartz.

174. Copyright Office, *supra* note 153.

175. Paul M. Gregory, *An Economic Interpretation of Women's Fashions*, 14 S. ECON. J. 149 (1947). Elizabeth Hawes was not only a fashion designer, but she spent the first part of her career as a fashion copyist for a major “knock-off” manufacturer. See ELIZABETH HAWES, *FASHION IS SPINACH* 13-47 (Grosset & Dunlap 1940) (the autobiography of Elizabeth Hawes).

In [*Fashion is Spinach*, Hawes] chronicled her start working for a French copy house . . . her return to New York to design her own line; and her ultimate disillusionment with the tyranny of mass production and the ubiquity of poor quality knockoffs that undercut her own designs. She ultimately closed her business in 1940, but not before leaving a record of the perils of the industry for a creative designer.

Scafidi, *supra* note 150. Hawes was known, not only for her contributions to the world of design, but also for her political activism.

176. 17 U.S.C. § 1309(a), (e) (2000).



for compensatory damages up to \$250,000 (or \$5 per copy),<sup>177</sup> the recoupment of profits, attorney's fees, and the destruction of all infringing articles.<sup>178</sup> This is, of course, as long as the infringement suit is brought within the statute's three-year statute of limitations.<sup>179</sup>

Although protection can be generally applied and infringement will occur in most situations where a design is copied, there are additional limitations. For one, with a minor amendment to the current section, proposed § 1309 prevents liability for parties who act without knowledge or reason to know that the copied design was in fact protected.<sup>180</sup> This would prevent litigation over an article that was not correctly identified as a copyrighted design.<sup>181</sup> According to the Copyright Office, although they have not publicly supported or opposed the bill, this "notice requirement . . . [would be] essential to any fashion design protection legislation."<sup>182</sup>

Additionally, the statute would allow the reproduction of a design "solely for the purpose of teaching, analyzing, or evaluating the appearance, concepts, or techniques embodied in the design."<sup>183</sup> Therefore, the use of a design in a fashion institute or other educational institution to instruct

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177. Compare 17 U.S.C. § 1323(a) (2000), with H.R. 5055 § 1(g), 109th Cong. (2006). The current statute affords damages "not exceeding \$50,000 or \$1 per copy, whichever is greater." 17 U.S.C. § 1323(a) (2000). Perceptibly, H.R. 5055 proposes a significant increase in the damages available for infringement. In the Copyright Office's report to Congress, it makes note that this proposal would effectively exceed the maximum award of statutory damages provided for copyright infringement under any section. Copyright Office, *supra* note 153. Although the Office did not take a stand on the issue, they advised that "Congress should not enact such a provision in a vacuum, without giving due consideration to the analogous provision in the Copyright Act . . . we are skeptical that the maximum award for infringement of a protected design should exceed the maximum award for copyright infringement." *Id.*

178. H.R. 5055 § 1(g), 109th Cong. (2006). Adding attorney's fees and the recoupment of profits to the list of remedies available to fashion designers would significantly widen their arsenal, and in turn, strongly discourage those who contemplate infringement. However, this addition should be a point of concern. Effectively, designers would not only be provided with the extensive remedies available through copyright, they would also have the option of bringing action and recovering for infringement under trademark law. See discussion *supra* Part III.B.

179. 17 U.S.C. § 1323(c) (2000).

180. H.R. 5055 § 1(d), 109th Cong. (2006); see also 17 U.S.C. 1309(c) (2000).

181. Under the current reading of the design protection statute, protected designs must bear proper notice of their registration. 17 U.S.C. § 1306 (2000). This notice is mandatory, unlike notice of traditional copyright. The design is required to list the year in which protection was granted in addition to "the name of the owner [of the design], an abbreviation by which the name can be recognized, or a generally accepted alternative designation of the owner." 17 U.S.C. § 1306(a)(1) (2000). The notice of registration must be affixed to the design in order to give "reasonable notice" that the design is protected. 17 U.S.C. § 1306(b) (2000). Therefore, if a designer registered his garment but failed to affix notice of such registration to his design, then an infringing article might be able to escape liability under the amended 17 U.S.C. § 1309 (2000).

182. Copyright Office, *supra* note 153 ("Competitors should be given clear notice of and opportunity to learn of a designer's claim of protection, so that they may avoid encroaching on the rights of a designer who wishes to claim protection under the new law.").

183. 17 U.S.C. § 1309(g) (2000).

regarding the design or function of the article would not violate the designer's copyright.<sup>184</sup>

Finally, any illustration or picture of a copyrighted design would not be deemed infringing.<sup>185</sup> Thus, the use of an illustration in an advertisement, motion picture, periodical, or similar medium would be permissible under the current wording of § 1309.<sup>186</sup> However, it is important to note that any photograph later used to contribute to the creation of infringing articles could subject the original user of the photograph to secondary liability.<sup>187</sup>

#### B. *Will it Work?*

Consider this statement from intellectual property scholar Jessica Litman:

Imagine for a moment that some upstart revolutionary proposed that we eliminate all intellectual property protection for fashion design. No longer could a designer secure federal copyright protection for the cut of a dress or the sleeve of a blouse. Unscrupulous mass-marketers could run off thousands of knock-off copies of any designer's evening ensemble, and flood the marketplace with cheap imitations of haute couture. In the short run, perhaps, clothing prices would come down as legitimate designers tried to meet the prices of their free-riding competitors. In the long run, though, as we know all too well, the diminution in the incentives for designing new fashions would take its toll. Designers would still wish to design, at least initially, but clothing manufacturers with no exclusive rights to rely on would be reluctant to make the investment involved in manufacturing those designs and distributing

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184. This fair use exception, although standard among copyright legislation, is an important one. In fashion design schools, it is common to use older garments in order to learn how to construct, design, and style with certain garments. Hypothetically, a class might be given the assignment to reconstruct a particular garment using the techniques of the designer. Without this exception, if the design were registered and the class occurred during its three months of protection, then each student in the class would potentially be infringing on that mark.

185. 17 U.S.C. § 1309(e) (2000). Therefore, websites like Style.com and I-Dressup would not be prevented from using photos or pictorial reproductions on their websites to either discuss or mix and match designer fashions. *See supra* notes 8, 71.

186. This portion of the statute serves a similar interest to the trademark rule allowing a registered mark to be reproduced in order to advertise a competitor's good. *See supra* note 94 and accompanying text. Therefore, a store may use photos in an advertisement for a sale in its store, or a movie may use a sketch of a design to refer to a designer's garment without infringing on the designer's copyright.

187. H.R. 5055 § 1(d), 109th Cong. (2006). *See supra* note 159 and accompanying text.

them to the public. The dynamic American fashion industry would wither, and its most talented designers would forsake clothing design for some more remunerative calling like litigation. All of us would be forced either to wear last year's garments year in and year out, or to import our clothing from abroad . . . Of course we don't give copyright protection to [fashion designs]. We never have.<sup>188</sup>

The above quote is the battle cry of all those who challenge legislation such as H.R. 5055. Opponents argue that the fashion industry, while an anomaly in some ways,<sup>189</sup> is driven by the ability to copy and has thrived in spite of it.<sup>190</sup> Therefore, they see no need in creating more legislation to control an issue that has yet to be a problem.<sup>191</sup> Still, designers find this to be a naïve approach to what they consider their art and the product of considerable blood, sweat, and tears—not to mention their significant monetary investment.<sup>192</sup> What is left is a complex dispute over whether designers are actually harmed by the current lack of intellectual property protection, or if their business increases because of it.<sup>193</sup>

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188. JESSICA LITMAN, *DIGITAL COPYRIGHT* 105-06 (Prometheus Books 2001).

189. See Christine Cox & Jennifer Jenkins, *Between the Seams, A Fertile Commons: An Overview of the Relationship Between Fashion and Intellectual Property*, in *READY TO SHARE: FASHION & THE OWNERSHIP OF CREATIVITY* 5 (The Norman Lear Center 2005) (examining “the reasons why fashion design generally is not protectable under existing intellectual property regimes, and . . . how the fashion experience might inform ongoing debates about desirable levels of intellectual property protection . . .”). See *infra* note 261 and accompanying text.

190. See Raustiala & Sprigman, *supra* note 34, at 1727-28 (“Original ideas are few, and the existence of fashion trends typically means that many actors copy or rework the ideas of some originator (or copy a copy of the originator’s design). Some may originate more than others, but all engage in some copying at some point . . . . Moreover, the industry’s quick design cycle and unusual degree of positionality means that firms are involved in a rapidly repeating game, in which a firm’s position as originator or copyist is never fixed for long. The result is a stable regime of free appropriation.”). See discussion *infra* Part V.B.1.c.

191. See Raustiala & Sprigman, *supra* note 34, at 1727-28. In their article, Raustiala and Sprigman claim “that piracy is paradoxically beneficial for the fashion industry, or at least piracy is not very harmful.” *Id.* However, they do not deny “that copying may cause harm to particular originators.” *Id.* Yet, they believe that “[e]ven originators that suffer harm . . . may not be strongly incentivized to break free of the low-IP equilibrium because, often, they are also copyists.” *Id.* Therefore, per their rationale, Raustiala and Sprigman see no reason to create legislation and burden the court system for an industry that is likely to thrive with or without protection. *Id.* However, before taking their economic argument too seriously, it is important to note that, in their analysis, Raustiala and Sprigman openly ignore the creative interests of the actual designers. *Id.* (“We do not deny, however, that copying may cause harm to particular originators.”).

192. See Banks, *supra* note 9, at 11 (“The fashion business is a tough business. With each new season, designers put their imagination to work, and they put their resources at risk.”). According to Banks, it is not right for designers to be forced to take all of the risk in creating a design so copyists can reap the profits. *Id.*

193. Compare Raustiala & Sprigman, *supra* note 34, at 1727 (arguing that “piracy is paradoxically beneficial for the fashion industry”), with Mencken, *supra* note 38, ¶ 45 (contending that “[t]he denial of copyright protection in garment designs sanctifies the outright theft of a designer’s creative work”).

## 1. The Players

With an industry that generates over \$750 billion a year worldwide,<sup>194</sup> it is only fitting that legislation aimed at controlling it would resonate throughout the world. The enforcement of the Design Piracy Prohibition Act involves more than just designers and those who knock-off their designs. The scope of this legislation is broad, potentially affecting courts,<sup>195</sup> consumers,<sup>196</sup> European designers,<sup>197</sup> and even citizens of countries like China and Taiwan.<sup>198</sup>

## a. Designers

It is the designers, in the United States and abroad, who will feel the immediate effects if H.R. 5055 does find its way into our legal system. In fact, almost instantly, design houses will be forced to reconsider their approach to developing lines and will pay close attention when taking “inspiration” from other designers.<sup>199</sup> The passing of such a bill would ultimately put certain companies known for knocking-off designs in jeopardy by forcing them to either reconfigure their business models or go out of business.<sup>200</sup> One such “designer” who would face reconfiguration is

194. Banks, *supra* note 9, at 2.

195. See *infra* notes 212-19 and accompanying text.

196. See *infra* notes 220-29 and accompanying text.

197. See *infra* notes 199-211 and accompanying text.

198. The brunt of pirated merchandise is manufactured in places like China and Taiwan where labor is cheap. See Palank, *supra* note 5 (“About two-thirds of the value of all counterfeit goods, which include apparel and handbags, seized between Oct. 1, 2003, and Sept. 30, 2005, by U.S. Customs and Border Protection were from China . . .”). If H.R. 5055 were codified, the jobs of many citizens in these countries would be at risk. “[I]n certain Asian countries, the counterfeiting industry is so large that strict public enforcement of anti-piracy laws would entail significant economic dislocation and is therefore generally avoided.” Jonathan M. Barnett, *Shopping for Gucci on Canal Street: Reflections on Status Consumption, Intellectual Property, and the Incentive Thesis*, 91 VA. L. REV. 1381, 1397 (2005) (citing Robert Marquand, *China's Pirate Industry Thriving*, CHRISTIAN SCI. MONITOR, Jan. 9, 2002, at 6). While this may be true, it is unlikely that companies will stop manufacturing garments in China. Manufacturers, though unable to pirate design, will presumably continue to construct their garments abroad where costs are lower.

199. This, however, guarantees to be a difficult task. According to writers David Bollier and Laurie Racine, copying is “an indispensable part of the process” and “strict market control is generally impossible.” David Bollier & Laurie Racine, *Ready to Share: Creativity in Fashion & Digital Culture*, in READY TO SHARE: FASHION & THE OWNERSHIP OF CREATIVITY 6-7 (Norman Lear Center 2005). Therefore, designers will be forced to search the copyright registrar for registrations, make sure their “interpretations” are significantly different from the original, or contact the designer for a license or permission to interpret the design in their own way. See H.R. 5055, 109th Cong. (2006).

200. Designers such as Allen Schwartz, Victor Costa, and Jack Mulqueen make the greater part of their profits from designs they copied directly from designer runway looks. See *supra* note 18; see

Allen Schwartz.<sup>201</sup> Schwartz's multi-million dollar company sells garments based on "celeb-couture"<sup>202</sup> in his boutique stores throughout the world.<sup>203</sup> Although he does create "inspired" designs that do not exactly copy couture garments, the bulk of Schwartz's business comes from creating designer looks-for-less.<sup>204</sup> Following the passage of H.R. 5055, not only would this line-by-line copying be illegal,<sup>205</sup> but Schwartz would be forced to create a new business model and in many ways recreate the goodwill associated with his fashions. With regard to European designers, "[m]ore foreign based designers may be inclined to bring their talents to the United States if they were granted protection, resulting in an increase in commerce, as well as employment opportunities in the United States."<sup>206</sup>

Opponents to H.R. 5055 argue that the same designers advocating protection will not be able to abide by the legislation due to the fashion industry's inherent need for copying.<sup>207</sup> They assert that the current system

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also Schmidt, *supra* note 119, at 863 ("[G]ross sales of apparel manufacturer Jack Mulqueen exceeded \$200 million in 1981."). If H.R. 5055 were to become law, the likelihood that such designers will continue to make the million dollar profits they do today is not great.

201. See *supra* note 18.

202. See Sarah Childress, *Proms Go Hollywood*, NEWSWEEK, May 18, 2005, <http://www.msnbd.msn.com/id/7888491/site/newsweek/?GT1=6542> (last visited Feb. 2, 2007). Basically, Schwartz takes designer runway garments and creates "less-costly imitations of designer dresses worn by the rich and well dressed." *Id.* This "phenomenon [is] fueled by women's magazines that devote an increasing number of pages to red carpet looks and television channels that spend hours scrutinizing each Oscar gown." *Id.*

203. A.B.S., Store Locator, Company Profile, [http://www.absstyle.com/asstd\\_pages.php?temp=storelocator](http://www.absstyle.com/asstd_pages.php?temp=storelocator) (last visited Jan. 26, 2007).

204. See Jennifer Steinhauer, *The Most Sincere Form of Flattery: Mass Marketing*, N.Y. TIMES, Nov. 7, 1997, at B1 (discussing Schwartz's design process and views on copying other designers work). "[T]he popularity of celeb-couture among teens has reached new heights," and according to Allen Schwartz, "each year sales are at least 10 to 20 percent higher than the last." Childress, *supra* note 202.

205. See *supra* Part V.A; see also H.R. 5055, 109th Cong. (2006).

206. Julie P. Tsai, *Fashioning Protection: A Note on the Protection of Fashion Designs in the United States*, 9 LEWIS & CLARK L. REV. 447, 467 (2005). Currently United States law provides little recourse for designers who market their designs in the United States. *Id.* If a foreign designer marketed his garments in the United States, he would subject his designs to copying with little or no recourse; "[t]hus, there is no incentive for foreign designers to bring their talents to the United States." *Id.* Additionally, Tsai argues that if United States designers are not afforded protection, they will lack incentive to keep their talents in the United States and will likely leave to design abroad where their creativity is protected. *Id.* at 467-68. According to Alain Coblenche, a lawyer for the CFDA, "the impetus for lobbying Congress now came from meetings with French and Italian designers who wanted similar standards [to those of Europe] applied to their work in the United States." Wilson, *supra* note 20.

207. In their essay, Lauric Racine and David Bollier recount an incident involving Nicholas Ghesquière, a star designer for the House of Balenciaga. See Bollier & Racine, *supra* note 199, at 26. Ghesquière copied a "highly idiosyncratic 1973 vest" by a lesser-known designer, Kaisik Wong. *Id.* The vest was included as part of Balenciaga's 2002 collection. *Id.* The "inspiration" was discovered by an intern for the website Hintmag.com who exposed it in one of its columns. *Id.* In response to the exposure, Ghesquière admitted the sampling and stated that he was "very flattered that people [were] looking at [his] sources of inspiration." *Id.* However, with respect to the proposed bill, this would not constitute infringement. A 1973 vest would have lost its copyright

works because “[f]ashion designers are free to borrow, imitate, revive, recombine, transform and share design elements without paying royalties or worrying about infringing intellectual property rights.”<sup>208</sup> Some designers see the effort to be futile, as copying occurs even among the most respected in their field.<sup>209</sup> Is there room for copyright protection in a world where creativity thrives on recreating what has already been done? Those in support of protection believe that there is. They argue that the Act will only prevent line-by-line copies from being made and provide ample room for taking inspiration from past garments and the work of others.<sup>210</sup> According to Gela Taylor, a designer for Juicy Couture, “this proposal is for people who are not inspired by anything but looking for an easy way to make money.”<sup>211</sup>

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protection over fifteen years before Ghesquière sampled it for his own collection. Therefore, although opponents argue that fashion is cyclical and therefore not protectable, fashion cycles would not be affected by a three-year copyright and designers would be free to take inspiration from vintage and older designer pieces.

208. Cox & Jenkins, *supra* note 189, at 16.

209. See Wilson, *supra* note 20. Although designer Jeffrey Chow’s garments are often duplicated and sold for less, he poses the question, “[h]ow do you copyright fashion design?” *Id.* He claims that “[fashion is] not like a typeface or a song . . . There are no boundaries in fashion.” *Id.* Additionally, Tom Ford was quoted as agreeing with a similar statement. See *supra* note 151; see also *supra* note 206. Consider the 1994 case involving Ralph Lauren and Yves Saint Laurent (“YSL”), two of the premier world-renowned couture fashion designers. See *Societe Yves Saint Laurent Couture S.A. v. Societe Louis Dreyfus Retail Mgmt. S.A.*, [1994] E.C.C. 512, 514 (Trib. Comm. (Paris)). In that case, YSL brought suit against Ralph Lauren in a Parisian court for making a line-by-line copy of an YSL tuxedo dress. *Id.* The court found Ralph Lauren’s \$1,000 version of the dress to be a copy of YSL’s \$15,000 original. *Id.* Ralph Lauren was fined \$383,000. *Id.* “Yves Saint Laurent has blown the whistle on the dirtiest secret in the fashion industry. None of them are above copying each other when they think they can make a fast buck.” Agins, *supra* note 69. Interestingly enough, in 1985, YSL was actually charged with copying and fined \$11,000 in a French court for sampling a jacket by designer Jacques Esterel. *Id.*

210. For instance, when “Memoirs of a Geisha” was released in 2005, Japanese influences, such as kimono sleeves and obi belts, were prevalent in the fashion world. Wilson, *supra* note 20. According to the CFDA, the use of these items in several collections would not be thwarted by the implementation of the resolution. See Lanman, *supra* note 148 (“The CFDA says it wants to stop actual copying and not the borrowing of ideas that ‘are in the air.’”). Additionally, the three-year protection period would allow designers to continue to use past designs as inspiration for their current collections.

211. Wilson, *supra* note 20. Stan Herman, the president of the CFDA, believes that the distinction is simple. *Id.* He maintains that “[i]t’s not as complex as everybody’s making it . . . . To take somebody’s design and make a line-for-line copy, that should be stopped.” *Id.* In his article, Wilson discusses two different examples of such precise replication. *Id.* First, he tells of a \$1,500 design made by Narciso Rodriguez that was found in a local newspaper advertisement for a nearly identical version retailing at \$199 at Macy’s. *Id.* Then, he reports of a \$169.99 purple satin dress being sold at Bloomingdales that is an exact replica of a \$1,000 Zac Posen design. *Id.* These are the types of line-by-line copying H.R. 5055 hopes to address. According to Valerie Salembier, the publisher of *Harper’s Bazaar*, “[copyists] are stealing at the expense of creativity . . . . It’s not fair or reasonable or correct to steal that design from someone.” *Id.* *Harper’s Bazaar* dedicated its January issue to

b. *Courts*

Even if designers are able to roll with the changes, courts may not be. Critics anticipate that the courts will spend countless hours and resources resolving the issue of originality with respect to a garment's design.<sup>212</sup> Acknowledging that the originality question is likely to be a difficult one, the Copyright Office has requested to be left out of such determinations.<sup>213</sup> Fashion reporter Guy Trebay sardonically noted:

Adolfo builds a wildly successful business on an interpretation of a boxy suit by Coco Chanel; lucky for him Ms. Chanel, being dead, is unable to litigate. Tom Ford becomes famous for copying Halston, Alexander McQueen for aping Vivienne Westwood. Half of fashion, in fact, seems to owe its professional existence to a single truism: one is as original as the obscurity of one's source.<sup>214</sup>

The battle over what is original and what is inspired is seen as the equivalent of opening Pandora's Box. Skeptics view H.R. 5055 as a "lawyer-employment bill" and claim it would turn the fashion industry "away from innovation and toward litigation."<sup>215</sup> Within the three-month registration period, a design could go from in to out, and the opportunities for infringement are limitless, opening the door for endless lawsuits.<sup>216</sup>

On the other hand, supporters believe that this tsunami of litigation predicted by adversaries of H.R. 5055 is prematurely anticipated.<sup>217</sup> They

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the problem of counterfeit fashion. *Id.*; see also *supra* note 3 and accompanying text.

212. See Wolfe, *supra* note 24. Wolfe contemptuously notes:

Because defining and determining originality is difficult enough for those who work in and study the fashion industry; it would be just as difficult for a court. If a court cannot determine the originality of a design, then how could it fairly determine whether one design infringes upon another or whether a design is substantially similar or whether a design is sufficiently original to qualify for copyright protection? Would a court be forced to measure the width of the lapels on a tuxedo jacket, the width of spaghetti straps on a cocktail dress, the similarity of pastels of a suit? Or the originality in the length of a skirt, the cut of a men's button-down dress shirt, or in the number of straps on a pair of gladiator-style sandals?

*Id.* Wolfe's statement does well in its comment on the frivolity of the analysis that skeptics believe courts will be forced to make.

213. See Copyright Office, *supra* note 153.

214. Bollier & Racine, *supra* note 199, at 14.

215. Sprigman, *supra* note 24.

216. "The lifespan of a legal dispute is longer than the attention span of the fashion industry." Wolfe, *supra* note 24. According to Wolfe, extending copyright protection to the fashion industry "would slow the rapid pace . . . which is what makes it profitable." *Id.* He argues that the thriving fashion industry, currently free from litigation, would get tied up and waste time dealing with injunctions, depositions, and trials. *Id.* "Rather than efficiently creating new fashion designs for the market, designers will be trapped in the perpetual chaos of trying to defend the copyright on existing designs while planning and producing designs for the future." *Id.*

217. See Banks, *supra* note 9 (asserting that copyright protection would be a powerful deterrent and stating that "[r]etailers have [said] that if the practice of fashion design piracy was illegal, they

hope to draw a comparison between the current European Union model of fashion copyright, where litigation is not rampant but is only used when necessary.<sup>218</sup> If this model is indicative, the use of the court system and copyright as a mode of protection would be rare and found mostly within garments at a higher price point.<sup>219</sup>

### c. Consumers

One of the most common arguments against protecting fashion designs involves the impact protection will have on consumers, who in all likelihood will be indirectly affected.<sup>220</sup> Opponents believe that enacting a resolution that will require higher royalties to be paid to designers and manufacturers to spend more money “developing” designs will inevitably cause the price of clothing to increase and place certain items outside the purchase range of some consumers.<sup>221</sup> They reason that in order to account for the costs of

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wouldn’t engage in it”). “[T]he case law in Europe indicates that designers understand that there is a certain level of inspiration and similar themes in each season, and have not been suing each other rampantly . . . . [A]n action for infringement arises when there is an exact copy made.” Mencken, *supra* note 38, ¶ 45.

218. France, the original protector of fashion designs, has always treated garments as equivalent to other forms of intellectual property. See Scafidi, *supra* note 150. “The formal recognition of fashion design as an art form has . . . helped maintain the preeminence of the French fashion industry and augmented the lasting creative influence of both native designers and those who have chosen to work in France.” *Id.* Since 2002, the European Union has extended copyright protection to fashion designs for a term of three years for unregistered designs and up to twenty-five years for registered designs. *Id.* Japan and India, along with many other countries, have also developed protection within their laws for fashion designs. *Id.*; see also Manisha Singh Nair, *India: Exploring Legal Spaces in Fashion*, MONDAQ, Sept. 5, 2006. In these countries, since the inception of their corresponding copyright protection laws, there has failed to be an overflow of copyright litigation. Proponents argue that the United States system would likely follow suit and abuse of the system would be minimal. However, opponents contend that the EU system is actually a point in their favor. According to Christopher Sprigman, “European law provides extensive protection for apparel designs, but the law does not appear to have had any appreciable effect on the conduct of the fashion industry, which continues to freely engage in design copying.” Sprigman, *supra* note 24. Sprigman believes that the EU system shows how ineffective protection for fashion designs will be, because design copying is just as prevalent in Europe and because the copyright system is rarely utilized by designers. *Id.* For an in-depth analysis of the European laws concerning fashion designs, see Hagin, *supra* note 18, at 370-74.

219. According to Banks, if registration were necessary to receive design protection, and design protection was only granted to those designs that were considered original, then designers would be forced to selectively register their garments. Banks, *supra* note 9; see also *supra* note 162 and accompanying text.

220. See Banks, *supra* note 9 (arguing that precluding fashion design protection will only hurt consumers); see also Wolfe, *supra* note 24 (arguing that fashion design protection would limit consumers’ choices and raise prices for designer clothing).

221. Wolfe argues that, in response to the extension of copyright protection, designers will become more cautious when creating their clothing lines. See Wolfe, *supra* note 24. “Ultimately,



litigation, licensing, and design, manufacturers will be forced to raise prices, thereby leaving consumers with costly products and fewer choices.<sup>222</sup> Then again, designers feel that although certain items might be out of the common consumer's reach, they will not be left without options.<sup>223</sup> In his testimony before Congress, designer Jeffrey Banks applied the opposing argument to other industries.<sup>224</sup> He found that "the same could be said for the protection of music, movies, software and books. If these works weren't protected by copyright . . . wouldn't prices come down for consumers?"<sup>225</sup>

Original designs occur at all price points, and not all designs will be monetarily out of reach for the consuming public. A recent example used by Susan Scafidi in her Congressional testimony is the popular Crocs "Beach" style shoes.<sup>226</sup> Originals sold for \$29.99, while copies of the shoe retailed for as little as \$10.00.<sup>227</sup> Yes, certain high-fashion designs may not be available to the common consumer, but how is that different from any other artistic arena? Price points for designer clothing will likely stay the same. And with increased opportunity to monopolize on their creativity, more designers will come out with ready-to-wear collections comprised of affordable versions of their couture and designer works.<sup>228</sup> Though manufacturers will be forced to avoid line-by-line copies of registered garments, "it is unlikely . . . that the fashion cycle as a phenomenon would cease to exist under a high-protection legal regime."<sup>229</sup>

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they would have to account for the costs of licensing and the risk of infringement litigation in their pricing, and pass these costs on to consumers. The end result for consumers will be fewer choices, higher prices, or both." *Id.*

222. *See id.* Although Sprigman spoke in opposition to the resolution before Congress, in his 2006 article concerning the extension of intellectual property protection to fashion designs, he stated that "[i]t is [highly] unlikely . . . that the fashion cycle as a phenomenon would cease to exist under a high-protection legal regime." Raustiala & Sprigman, *supra* note 34, at 1734. It seems that Sprigman is arguing that protection for fashion is not needed and the industry is thriving without protection. *Id.* However, he does not seem to think that the overall effects of the imposition of protection would alter consumers' buying habits or the overall nature of the industry. *See id.*

223. *See* Scafidi, *supra* note 150; *see also infra* notes 226-29 and accompanying text.

224. *See* Banks, *supra* note 9. Banks argues that the protection of fashion designs is similar to other industries such as music, movies and software. He recognizes that some of the same proponents of limiting copyright protection in these areas are now focused on preventing the protection of fashion designs. *Id.*

225. *Id.*; *see infra* note 261 and accompanying text.

226. Scafidi, *supra* note 150; *see also* Crocs, <http://www.crocs.com>.

227. Scafidi, *supra* note 150.

228. *See* Briggs, *supra* note 74, at 210-13. Briggs argues that if designs were protected, not only would more designers develop ready-to-wear collections to sell to the purchasing public, but they "could charge less for each design, knowing that their investment would be returned over a longer period of time." *Id.* at 210.

229. Raustiala & Sprigman, *supra* note 34, at 1734; *see supra* note 222.

## 2. The Art

Congress was charged by the framers of the Constitution to create a statute that would provide an incentive for artists, authors, and scientists to continue to create and explore creative arenas.<sup>230</sup> The incentive to create has since been the philosophy behind the extension of copyright protection to different fields.<sup>231</sup> Fashion designers hope to use the incentive philosophy to pass H.R. 5055 through Congress and into the United States Code.

The social perspective of apparel was once one of utility, but modern fashion design has separated itself from mere clothing as a mode of creative and self expression.<sup>232</sup> Contemporary attitudes have begun to embrace fashion design as a respectable creative medium.<sup>233</sup> Museums across the world have acknowledged the artistic works of talented designers.<sup>234</sup> For

230. VAIDHYANATHAN, *supra* note 116, at 21. "Without a legal guarantee that they would profit from their labors and creations, the Framers feared too few would embark on creative endeavors." *Id.* at 21. "Copyright was created as a policy that balanced the interests of authors, publishers, and readers. It was not intended to be a restrictive property right." *Id.* at 20. Therefore, the framers drafted the Act so "authors [could] enjoy this monopoly just long enough to provide an incentive to create more, but the work [would] live afterward in the 'public domain,' as common property of the reading public." *Id.* at 21; *see also supra* note 120 and accompanying text.

231. VAIDHYANATHAN, *supra* note 116, at 21. The argument behind the incentive theory insinuates that if there were no copyright laws protecting works from unscrupulous fraudsters who would copy and sell at a lower price, then authors and artists would no longer create because they would not be able to reap the rewards of their hard work. *See supra* note 230. However, Vaidhyathan argues that the idea of copyright as a "property right" has emerged from this perspective. VAIDHYANATHAN, *supra* note 116, at 21-22. She believes that this new approach to copyright runs afoul of the original purpose of the Copyright Act. *Id.* at 22.

232. *See Scafidi, supra* note 150. Scafidi contends that fashion is not solely driven by function. *Id.* "If it were, we could all simply wear our clothes until they fell apart or no longer fit." *Id.* She argues that because fashion is a form of creative expression, it is therefore within the scope of what copyright was intended to protect. *Id.*; *see also* CAROLINE EVANS, *FASHION AT THE EDGE* (Yale University Press 2003) (discussing the expressionist nature of the fashion industry and its evolving comments on society).

233. *See Scafidi, supra* note 150. The work of artist and designer Elsa Schiaparelli is known for the artistic aspect of her garment designs. *See* Josh Patner, *Aftershock: What Happened to the Provocative Elsa Schiaparelli?*, SLATE, Nov. 24, 2003, <http://www.slate.com/toolbar.aspx?action=print&id=2091431> (last visited Feb. 2, 2007) ("Schiaparelli is widely recognized as the designer who worked with surrealists. One imagines this is partly why she has been given a museum show."). She was recently recognized at the Philadelphia Museum of Art with a show entitled "Shocking! The Art and Fashion of Elsa Schiaparelli." *Id.* Although fashion has made great headway in the artistic realm, there are still those who stand by the maxim that "[f]ashion is not art, and posturing doesn't make it so." *Id.*

234. The Costume Institute of the Metropolitan Museum of Art in New York City hosted the Goddess Exhibit in 2003. Metropolitan Museum of Art, Special Exhibition: *Goddess* (Apr. 28 – Aug. 3, 2003), [http://www.metmuseum.org/special/Goddess/goddess\\_more.htm](http://www.metmuseum.org/special/Goddess/goddess_more.htm) (last visited Aug. 25, 2007). The exhibit "presented the goddess as both an iconic artistic image and a tradition of dress design." Bollier & Racine, *supra* note 199, at 16. Likewise, in 2003, London opened a museum dedicated to the global achievements of the fashion industry. *Fashion Museum Breaks New*

example, the Metropolitan Museum of Art recently created a special exhibition displaying the designs and evolution of the House of Chanel.<sup>235</sup> The exhibit focused on the elements of Chanel's design juxtaposed with the work of current couturier for the House of Chanel, Karl Lagerfeld.<sup>236</sup>

Even courts have changed their attitude toward apparel with respect to the law.<sup>237</sup> In *Poe v. Missing Persons*, the Ninth Circuit addressed whether fashion could be viewed as art.<sup>238</sup> A fashion designer created a swimsuit filled with colored rocks entitled "Aquatint No. 5" that was copied by another party.<sup>239</sup> In its "useful article" analysis, the court stated that "the only reason for existence of Aquatint No. 5 was as a work of art."<sup>240</sup> When confronted with a similar issue in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, the Second Circuit held that decorative belts were "[p]ieces of applied art" and were copyrightable as a matter of law.<sup>241</sup> Although this view has not been adopted by all courts, it is obvious that most often apparel sells because of its aesthetic as opposed to its utilitarian function.<sup>242</sup> One has to only attend a couture fashion show and witness the extravagance of Galliano

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*Ground*, CNN.com, May 12, 2003, <http://www.cnn.com/2003/WORLD/europe/05/12/design360.fashion.museum/> (last visited Feb. 5, 2007). In Japan, the Kobe Fashion Museum is dedicated solely to the realm of fashion designs. Kobe Fashion Museum, [http://www.fashionmuseum.or.jp/src/e\\_museum.php](http://www.fashionmuseum.or.jp/src/e_museum.php).

235. Metropolitan Museum of Art, Special Exhibition: Chanel (May 5 – Aug. 7, 2005), [http://www.metmuseum.org/special/chanel/chanel\\_more.htm](http://www.metmuseum.org/special/chanel/chanel_more.htm) (last visited Feb. 5, 2007). The exhibit showcased more than fifty garments and accessories highlighting the history of the House of Chanel and the elements of Chanel's work. *Id.* The work of Coco Chanel was juxtaposed with the current contributions of Karl Lagerfeld to the House of Chanel. *Id.*

236. *Id.*

237. See *Nat Lewis Purses, Inc. v. Carole Bags, Inc.*, 83 F.2d 475, 476 (2d Cir. 1936) ("True, the piracy of designs, especially in wearing apparel, has been often denounced as a serious evil and perhaps it is; perhaps new designs ought to be entitled to a limited copyright."). See *infra* notes 238-42 and accompanying text.

238. 745 F.2d 1238 (9th Cir. 1984). In Poe's declaration, he described the swimsuit "as an eccentric and controversial piece of . . . an artwork, not clothing. It is an artists [*sic*] impression or rendering of an article of clothing and in this context, [he] developed, created and originated this work as an artist. It stands by itself as a work of conceptual art." *Id.* at 1240. Poe had previously described the article as a "three dimensional work of art in primarily flexible clear-vinyl and covered rock media" in his application for a copyright. *Id.*

239. *Id.*

240. *Id.* at 1242.

241. 632 F.2d 989, 993-94 (2d Cir. 1980). In *Kieselstein-Cord*, a belt buckle designer developed belt buckles that the court considered "sculptured designs cast in precious metals—decorative in nature and used as jewelry is, principally for ornamentation." *Id.* at 990. The copyrighted belt buckle received a 1979 Coty American Fashion Critics' Award and was accepted by the Metropolitan Museum of Art to be added to its permanent collection. *Id.* at 991. The court held that the copying of these designs infringed on the belt designer's copyright and dismissed the argument that the designs were "mere variations of 'the well-known western buckle.'" *Id.* at 993-94.

242. Over the course of time, the development of trends is not concentrated on the utilitarian function of the designs, but rather their aesthetic style. Mencken, *supra* note 38, ¶ 20. Therefore, the "chief value of a 'quality' dress lies, not so much in the quality of the material, as in the smartness and originality of the design." *Id.* ¶ 21 (citing *Wm. Filene's Sons Co. v. Fashion Originators' Guild of Am.*, 14 F. Supp. 353, 354 (D. Mass. 1936)).

for Dior<sup>243</sup> or the creative structure of Balenciaga<sup>244</sup> to find that the line between fashion and utility is not only blurred, but often nonexistent.<sup>245</sup> Fashion shows have turned into artistic social commentaries,<sup>246</sup> and designer boutiques are increasingly more like museums.<sup>247</sup> Fashion is no longer solely about function. "As with any artistic endeavor, the number of possible creative expressions is only as limited as the human mind, and in haute couture, no one has yet to stop inventing."<sup>248</sup>

Even so, those against the implementation of H.R. 5055 continue to see the current definition of copyrightable material, which excludes "useful articles" from obtaining any sort of protection, as a barrier.<sup>249</sup> Opponents argue that fashion design is not within the definition of intended copyrightable subject matter, mainly because no incentive is needed for

243. See WATSON, *supra* note 22, at 142-43 (discussing the design history and genius of designer John Galliano).

244. See *id.* at 95 (detailing the history of the House of Balenciaga).

245. Often times couture shows are so enveloped with design and creativity that the clothes are not wearable in a setting outside a photo shoot. Take Dior for example—with John Galliano at the head of the design team, Dior couture has become increasingly more extravagant and avant-garde. Such designs would never make it onto the street in their runway form. Or consider the work of Roberto Capucci, where "the extravagance of some experiments [evolved so] that the wearer [became] secondary to the gown." THE FASHION BOOK 87 (Phaidon Press Limited 1998).

246. See Lauren Goldstein, *Viktor & Rolf*, TIME EUROPE, <http://www.time.com/time/europe/specials/ff/trip6/ptw/index.html> (last visited Feb. 6, 2007) ("The hybrid of art and fashion that Viktor & Rolf so distinctively—so uniquely—make cannot be measured against art or fashion alone."). Viktor & Rolf show their designs, not on runways, but rather in museums. *Id.* The runway show has evolved from its initial purpose—selling garments—and has become a means of artistic expression for the designer and his collection. See FASHION NOW, *supra* note 18, at 268-69 (showcasing a photograph of a 2000 Chanel couture runway show held along a pool of water).

247. See Jeff Chu, *You Know How It Is: Walk Into a Boutique and You Wonder Where They're Hiding the Clothes*, TIME EUROPE, <http://www.time.com/time/europe/fashion/0902/dialogue.html> (discussing designers' recent move toward more art-like boutiques). The Soho Prada store in New York City is an example of designers' move toward more artistic boutiques. The window to the boutique is filled with mannequins in extravagant clothing displayed in a visually appealing manner. Visitors looking to actually purchase must walk down a rounded staircase, blended into a curved floor, which runs to the basement where the actual "boutique" is located. From the outside, a passerby unfamiliar with the store might not recognize it as one. In the final season of *Sex and the City*, Carrie takes her then-boyfriend, Jack Berger, on a tour of "The Prada" in Soho. *Sex and the City: Lights, Camera, Relationship!* (HBO television broadcast July 20, 2003). Upon seeing the inside of the store, Berger quips, "[y]ou know, on my planet, the clothing stores have clothes." *Id.*

248. Mencken, *supra* note 38, ¶ 5.

249. See *supra* Part III; see also Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y U.S.A. 339 (1990) (discussing the issues surrounding the copyrightability of useful articles and the idea of conceptual separability). However, Christopher Sprigman, who spoke in opposition to H.R. 5055, argues that the current copyright doctrine does not serve as a barrier to extending copyright protection to fashion designs. See Sprigman, *supra* note 24, at 1745 (arguing that the useful articles rules "are not part of the viscera of U.S. copyright" and therefore, the useful articles doctrine does not effect sui generis protection).

designers to continue to create garments to be sold on the marketplace.<sup>250</sup> They believe that the fashion industry is thriving *in spite* of the lack of protection.<sup>251</sup> Supporters view the issue from a different angle. In her article *Hung Out to Dry: Clothing Design Protection Pitfalls in United States Law*, Anne Briggs attributes the adversary's defeatist attitude to "an inferiority complex about the ability of American design to compete with European design."<sup>252</sup> Briggs proposes that skeptics of design protection are not really skeptics of legislation, but rather designers' ability to compete with designers in Europe in a world where copying is not permitted.<sup>253</sup> Similarly, designers argue that the proposal is not solely about copying, but rather developing and encouraging new talent.<sup>254</sup>

The question becomes one of who copyright is supposed to benefit. According to Siva Vaidhyanathan, "as a result of schools of legal thought that aim to protect 'property' at all costs and see nothing good about 'public goods,' copyright has developed as a way to reward the haves: the successful composer, the widely read author, the multinational film company."<sup>255</sup> She

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250. Sprigman, *supra* note 24. Sprigman argues that intellectual property rules would provide no incentive for fashion designers to create. *Id.* Instead, he maintains that it is consumers' preference for change in clothing designs that serves as encouragement to designers. *Id.* Keep in mind, Sprigman is not arguing that fashion designs are not *able* to be copyrighted, but rather, that they should not be. See *supra* note 249.

251. See Sprigman, *supra* notes 24, 250.

252. Briggs, *supra* note 74, at 207-08. Briggs maintains that her "proposition is well supported by the history of American clothing design, in which numerous examples can be found of the frequent theft of European design by Americans." *Id.* at 207. For additional support, she quotes the legislative history of the 1914 design protection act where a representative stated:

I have been told by some manufacturers, when this matter has been presented to them, "Oh, we can not live . . . unless we copy our competitors' designs. We can not produce designs like they do in Europe." I always feel a little ashamed of an American who will make that acknowledgement because I believe that with the right kind of protection and the right kind of encouragement, the United States of America can lead in designing as it can lead in everything else . . . .

*Id.* at 207-08 (quoting *Registration of Designs: Hearings on H.R. 11321 Before the H. Comm. on Patents*, 63d Cong. 96-97 (1914) (statement of E. W. Bradford, Esq., General Counsel for the Desing Registration League)).

253. *Id.*

254. See Scafidi, *supra* note 150. In her testimony, Scafidi relates the account of handbag designer Jennifer Baum Lagdameo. *Id.* Lagdameo co-founded Ananas, a handbag company, about three years ago. *Id.* Ananas had initially been successful in marketing its handbags, which retail from \$200 to \$400. *Id.* According to Scafidi, Lagdameo received a telephone call canceling an order for a handbag, claiming that the buyer had found copies of the bag at a lower price. *Id.* Additionally, a message board was posted online enlightening online shoppers of this phenomenon and informing them of where to buy these knockoffs. *Id.* This development ended in losses to the small business. *Id.* Due to pervasive copying, young designers closing their businesses have "[become] part of the latest American fashion trend." Horyn, *supra* note 18.

255. VAIDHYANATHAN, *supra* note 116, at 5; see also Meir, *supra* note 26. Opponents to fashion design protection find that "[t]he trouble with [the] bill is that it is for the benefit of two parties; that is, the enormously rich who want to display their splendid apparel . . . and those rich concerns who have these extra and selected designers to design these special patterns for those elite." *Id.* Vaidhyanathan believes that this is the problem with modern copyright protection and attributes it to

believes that such protection was not meant to help the Giorgio Armanis of the world make more money, but rather “students, teachers, readers, library patrons, researchers, freelance writers, emerging musicians, and experimental artists.”<sup>256</sup> But what about the couture fashion designer? Although big-name fashion designers are likely to benefit from copyright protection, supporters of the bill argue that its primary purpose is to keep new talent designing and in business.<sup>257</sup> It is commonplace for new young designers to close their doors largely “because upstart chains like Zara . . . can quickly duplicate the latest runway styles at low cost.”<sup>258</sup> With the implementation of the Design Piracy Prohibition Act, new talent will be able to create and develop ideas without the fear of losing work to a discount manufacturer within minutes of its publication.<sup>259</sup> Newcomers will actually benefit from their originality, and hopefully, stay afloat. According to Vaidhyathan, this is what intellectual property protection is all about. After all, “[t]he lifeblood of [the fashion] industry is new ideas . . . . If we don’t support the young people coming along, we’re going to have a dead market.”<sup>260</sup>

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the “schools of legal thought that aim to protect ‘property’ at all costs . . . .” VAIDHYATHAN, *supra* note 116, at 5.

256. *Id.*

257. *See* Banks, *supra* note 9. Banks contends that, while larger designers are able to withstand the pervasive copying of their designs, it is the young designers who are unable to handle the blow to their businesses. *Id.* “[I]t prevents Marc Bouwer or Zac Posen from being able to develop the affordable ready-to-wear line of their own designs.” *Id.* Without the ability to expand their designs into ready-to-wear and lesser priced markets, the young designer is missing out on the opportunity to tap into the largest pool of profits. *See supra* notes 38, 50.

258. Horyn, *supra* note 18. According to Horyn, “[i]n the last decade, no new American talent has shown the staying power needed to be the next Calvin Klein, Donna Karan or Ralph Lauren . . . .” *Id.* Without the monetary backing needed to get their name out and create high-profile accessory lines, young designers are unable to keep their heads above water. Unfortunately, their main competition is often their own designs, just cheaper. *Id.* The rate the industry is going, “it will severely limit America’s ability to compete with large European brands, which have been aggressively developing new talents like Stella McCartney.” *Id.* Supporters of H.R. 5055 contend that this is their focus behind the bill—sustaining the creative industry; *see also* Rachel Tiplady, *Zara: Taking the Lead in Fast-Fashion*, BUS. WK. ONLINE, Apr. 4, 2006, [http://www.businessweek.com/globalbiz/content/apr2006/gb20060404\\_167078.htm](http://www.businessweek.com/globalbiz/content/apr2006/gb20060404_167078.htm) (discussing the business plan of apparel manufacturer Zara and its impact on the industry).

259. Because the taking of designs without permission from the designer would subject manufacturers to liability, young talent will be afforded the time and opportunity to reap the reward for the work and investment made in their designs. With the increase in revenue and the time to monopolize on their own work, such designers will have the opportunity to create less-expensive lines based on their former work. Moreover, they will no longer be forced to compete with lower-end replications of their own garments. If a buyer wants a certain design, she will have to buy it from its creator. Hopefully, with these alterations, new designers will be provided an opportunity to stay in business.

260. Horyn, *supra* note 18.

### 3. The Economy

Susan Scafidi, visiting professor at Fordham Law School, made the following observation:

In historical terms, the pattern of industrial development in the U.S. and more recent emerging economies often commences with a period of initial piracy, during which a new industry takes root by means of copying. This results in the rapid accumulation of both capital and expertise. Eventually the country develops its own creative sector in the industry, which in turn leads to enactment of intellectual property protection to further promote its growth. This was the pattern followed in the music and publishing industries, in which the U.S. was once a notorious pirate nation but is now a promoter of IP enforcement. In the case of the American fashion industry, however, the usual pattern of unrestrained copying followed by steadily increasing legal protection is not present.<sup>261</sup>

Why has fashion been left out? Since the termination of the Guilds,<sup>262</sup> it has been argued that affording protection to fashion designs would effectively provide well-known designers with a monopoly on the market.<sup>263</sup> With control vesting in a select few, talented young designers, such as Zac Posen or Cat Swanson, would be incapable of breaking into the industry.<sup>264</sup> Still, with respect to the modern industry, the argument has been made that such a monopoly could no longer exist.<sup>265</sup> Fashion centers are no longer

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261. Scafidi, *supra* note 150. See Tsai, *supra* note 206, at 449 (discussing the evolution of other creative industries and their breakthrough to intellectual property protection). Once record pirating highs were reached in each industry, “Congress recognized a need to pass legislation granting protection to those previously unprotected areas.” *Id.* Proponents of fashion design protection hope that H.R. 5055 will be the catalyst for a similar response to the piracy in the fashion industry.

262. See *supra* notes 127-35 and accompanying text.

263. See Sprigman, *supra* note 24. Sprigman contends that the introduction of copyright would mean more legal costs, and in turn, would force young designers who are unable to afford those costs out of the market. *Id.* He argues that over time the fashion industry will likely be dominated by a few large firms, much like the music and movie industries. *Id.*

264. “We believe that the end result of H.R. 5055 could be less consumer choice, fewer opportunities for young designers and small firms to break into the industry, and reduced consumption across the board of fashion goods.” *Id.* Again, it is interesting to compare this contention with Sprigman’s statement in his article (which was actually published *following* his testimony before Congress) that suggests “the fashion industry may also be able to thrive in a high-IP environment . . . .” Raustiala & Sprigman, *supra* note 34, at 1734. Although Sprigman believes that there will be some limitation to the reworking of designs, he has found that “the extant legal regime likely has some causal effect on the structure of innovation in the fashion industry, but not an overwhelming effect.” *Id.* Compared with his prior testimony, one has to wonder how Sprigman can reconcile this argument with the one he made before Congress on July 27, 2006.

265. See Mencken, *supra* note 38, ¶ 15 (using the French system of protection as an example of the effects of granting intellectual property rights to works of fashion).

localized, but rather, they are found in every major city across the world.<sup>266</sup> And while the reputable design houses of Chanel and Yves Saint Laurent<sup>267</sup> continue to thrive, it is the young designers who continue to push the envelope and are taking over the market.<sup>268</sup> Supporters maintain that the French system of protection, which has acknowledged fashion designs since 1793, is indicative of what to expect.<sup>269</sup> Not only is France the core of the design world, but design protection has not interfered with French designers' ability to create new designs, or with the Parisian ability to purchase clothing and dress impeccably.<sup>270</sup>

Nevertheless, opponents continue to argue that the current lack of intellectual property protection within the realm of fashion sustains the industry and, by lowering prices, actually increases the business of high-end designers.<sup>271</sup> Their argument is based on an induced obsolescence theory, which basically states that the mass manufacturing of garments contributes to a more rapid antiquation of designs because they quickly move from the elite to the masses.<sup>272</sup> In turn, new designs must be developed which are

266. See *supra* note 36 and accompanying text; see also Mencken, *supra* note 38, ¶ 15.

267. See WATSON, *supra* note 22, at 112, 219.

268. See Mencken, *supra* note 38, ¶ 15 n.59 ("The works of Dolce & Gabbana, Todd Oldham, Jean Paul Gaultier, and countless others all command more press and profits than many of the older houses."). Another prime example is young designer Marc Jacobs, who has more than made his name in the fashion industry.

269. *Id.* ¶ 15 (arguing that the European fashion industry has not been harmed by protection, but rather, that the designers are refusing to sell their designs in the United States where they are not protected). See Gibbons & Hobbs, *UK Copyright in Dress Designs*, 1 EUR. INTEL. PROP. REV. 8 (1979) (analyzing the United Kingdom Copyright Act and its treatment of fashion designs); see also John G. Castel, *Seasonal Industries and Design Piracy—Recent Trends*, 35 J. PAT. OFF. SOC'Y 761 (1953) (analyzing the French copyright laws and their treatment of fashion designs). In the United Kingdom, fashion designs are protected only if they are supported by a copyrighted drawing of the design. Schmidt, *supra* note 119, at 874 n.94. Alternately, in France, apparel can be protected as applied art or as a nonfunctional design. *Id.* "[A] 1952 change in the French law allows protection of garment designs without any showing of originality; instead, goods are protected once they have become popular with the public." *Id.* (citing 1 COPYRIGHT LAWS AND TREATIES OF THE WORLD (France) item 18, at 1-2 (UNESCO 1977)). The protection provided in Europe is much more extensive than that proposed by H.R. 5055, and yet the European fashion industry has not stilled but flourished. See Mencken, *supra* note 38, ¶ 15.

270. In an interview with Marc Jacobs, Ingrid Sischy comments that she is "always amazed by how much the goings-on of fashion seem to infiltrate into the Parisian consciousness." Inside Paris Fashion—Marc Jacobs, [http://www.findarticles.com/p/articles/mi\\_m1285/is\\_10\\_31/ai\\_78738605](http://www.findarticles.com/p/articles/mi_m1285/is_10_31/ai_78738605) (last visited Feb. 5, 2007). In response, Jacobs observes that, "[i]t's funny how tuned in to fashion Parisians are. I think it's part of the art of living for, [sic] them." *Id.*; see also *supra* note 218.

271. See Raustiala & Sprigman, *supra* note 34, at 1733; see also Wolfe, *supra* note 24.

272. This argument centers on the idea that designers sell more clothes the sooner the designs diffuse. See Raustiala & Sprigman, *supra* note 34, at 1733. Therefore, the quick turnover contributes to "a market in which consumers purchase apparel at a level well beyond that necessary simply to clothe themselves." *Id.* Opponents argue that the pervasive copying of designs is what



then copied, dropping prices and raising sales.<sup>273</sup> When it is complete, the cycle starts all over again.<sup>274</sup> In response to such an argument, Jennifer Mencken contends that “[t]he denial of copyright protection in garment designs sanctifies the outright theft of a designer’s creative work.”<sup>275</sup> She believes that this threat to the marketplace viability, rather than having an effect of bringing prices down, actually increases the cost of designer goods, resulting in fewer consumers being able to purchase designer garments.<sup>276</sup> While Mencken’s view is perhaps a stretch, and piracy is paradoxically beneficial to the fashion industry as a whole, the copying of designs is not necessarily optimal for the creators of the designs or consumers.<sup>277</sup> Though it becomes clear through analysis that some protection for designers is needed,<sup>278</sup> the current reading of H.R. 5055 leaves some questions unanswered.

## VI. WHAT IT WILL TAKE: SUGGESTED MODIFICATIONS

In order for the Design Piracy Prohibition Act to effectively regulate the ever-changing fashion industry, it is likely the resolution will be forced to

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induces this speedy turnover, largely because the “fashionable” do not want to be wearing the same designs as the masses. See Barnett, *supra* note 198, at 1398-1408 (arguing that the consumption of designer goods is attributed to the upper class’ desire to distinguish itself from members of the lower class). Barnett argues that “[t]o the extent that counterfeits increase the status benefits conferred by visibly using the original version of the relevant luxury good, the introduction of counterfeits should increase the profit-maximizing price that producers of the original can demand from snob consumers.” *Id.* at 1402.

273. See *supra* note 272 and accompanying text. “More fashion goods are consumed in a low-IP world than would be consumed . . . because copying rapidly reduces the status premium conveyed by new apparel and accessory designs, leading status-seekers to renew the hunt for the next new thing.” Raustiala & Sprigman, *supra* note 34, at 1733. “To the extent that counterfeits increase the status benefits conferred by visibly using the original version of the relevant luxury good, the introduction of counterfeits should increase the profit-maximizing price that producers of the original can demand from snob consumers.” Barnett, *supra* note 198, at 1402.

274. Raustiala & Sprigman, *supra* note 34, at 1728 (“[T]he industry’s quick design cycle and unusual degree of positionality means that firms are involved in a rapidly repeating game, in which a firm’s position as originator or copyist is never fixed for long.”).

275. Mencken, *supra* note 38, ¶ 45.

276. *Id.* Mencken contends that designers’ current profits can not be causally related back to the lack of IP protection. *Id.* Instead, she maintains that the profit they do make is the result of consumer demand in response to the designers’ creativity and ingenuity. *Id.*

277. See Raustiala & Sprigman, *supra* note 34, at 1722-32 (arguing that though an anomaly, pirating designs is beneficial to the fashion industry). Although Raustiala and Sprigman maintain that the copying of designs is ultimately beneficial to the fashion industry as a whole, they make note that they do not believe that it is the best case scenario for fashion designers. *Id.* For some opponents, the fashion design industry is an example of how an industry can thrive on its own without protection. See Bollier & Racine, *supra* note 199, at 5 (arguing that an uncontrolled environment, like the fashion industry, is “one of the most powerful ways to nurture innovation”). However, according to Henry Lanman, “fashion may not have been blazing its own trail by showing how a creative industry can work in a relaxed intellectual-property regime. Rather it simply may have been the last creative business to get onto the bus to lawyerville.” Lanman, *supra* note 148.

278. See discussion *supra* Parts II, III, V.B.

undergo some modifications.<sup>279</sup> First, a more precise definition of “original” in the context of fashion would be needed for courts to interpret the legislation consistently and appropriately.<sup>280</sup> Considering the contention that the purpose of the Act is to prevent line-by-line knockoffs of designer garments, as opposed to inspirational ideas and common elements that are “in the air,”<sup>281</sup> the language of the resolution should more austere reflect this stringent standard. As is, judges with modest knowledge of the fashion industry would be provided with little to aid them when presented with minute details that may make a major difference in a design. A more precise definition would not only assist the courts in their “originality” analysis, but it would also ensure that those whom the resolution was meant to support receive the benefit of such legislation. “The result is a necessarily thin copyright which provides protection for garment designs from outright theft but does not seek to completely overburden the copyright system.”<sup>282</sup>

In addition, although the Copyright Office has acknowledged the appropriateness of the resolution’s period of protection,<sup>283</sup> a shorter term might be more suited for the industry. Within three years, a design plausibly could go from valuable to worthless. In order to maintain the current vitality of the industry,<sup>284</sup> while also serving the interests of designers, limiting the proposed time by a year—making the period of protection two years—would do the economy as a whole a greater service. Young designers would be given the opportunity to create their lines, present them at runway shows, advertise them in media, develop ready-to-wear lines based on those designs, and market them before knockoff manufacturers

279. An additional modification that may be appropriate is the removal of belts and eyeglass frames from the definition of apparel protected by the resolution. See H.R. 5055, 109th Cong. (2006). Yet, this modification is not one this Comment is prepared to suggest. It is important to note, however, that the Copyright Office has acknowledged that “[t]o the extent that the Office has been presented with anecdotal evidence, that evidence relates to clothing designs. While there may well be similar evidence relating to the [alternate] items . . . of proposed § 1301(b)(9), the Office currently is not aware of such evidence.” Copyright Office, *supra* note 153. Furthermore, it may also be beneficial to amend the proposed damages in § 1323(a). “The [Copyright] Office recommends that Congress consider a complete revision of § 1323(a) that would offer clearer guidance relating to the calculation of damages for infringement.” *Id.*

280. This Comment proposes that Congress adopt a similar reading to the one currently in the resolution. In addition, a precise definition for the term “substantially similar” should also be included within the provision. Such a definition should recognize the difference between exact replications of a design or those slightly altered, and one that has merely utilized certain elements of a particular design idea.

281. See *supra* notes 210-11 and accompanying text.

282. Mencken, *supra* note 38, ¶ 44.

283. See Copyright Office, *supra* note 153; see also *supra* note 170 and accompanying text.

284. See discussion *supra* Part II.

would be able to touch them.<sup>285</sup> However, after two years have ended, if a design is still all the rage, then manufacturers will be able to produce it for the masses, providing the common consumer the opportunity to own designer-like garments.<sup>286</sup> Reducing the protection period would also bring the resolution closer to current European copyright which only extends protection for one year.<sup>287</sup> While other propositions have suggested a term of one year to be sufficient,<sup>288</sup> this Comment sees reason to extend the European period in response to opponents' arguments that the European system is underused and therefore useless.<sup>289</sup> The addition of an extra year of protection would create a greater incentive for designers to utilize the copyright system and register potentially profitable designs.

Finally, it has been argued that a successful fashion copyright proposal would recognize the need for a compulsory license system.<sup>290</sup> The implementation of a system where a manufacturer has the opportunity to make an interpretation of a design by paying a statutory fee would expectedly reduce the litigation over infringement.<sup>291</sup> Similar compulsory

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285. In her testimony, Susan Scafidi maintains that a period of three years would provide "designers time to develop their ideas in consultation with influential editors and buyers prior to displaying the work to the general public, followed by a year of exclusive sales as part of the designer's experimental signature line, and another year to develop diffusion lines or other mass-market sales." Scafidi, *supra* note 150; *see also supra* note 171. While her considerations are relevant, there is nothing to suggest that these same objectives could not be met in a shorter term of two years—especially considering that the first year Scafidi accounts for would not constitute protection since the work would have yet to be published.

286. Copyists would no longer be forced to entirely reconfigure their businesses because original designs would be available to them within the two-year period. *See supra* notes 200-05 and accompanying text. For example, A.B.S. could take orders for a dress that was worn on the red carpet just two years prior. While initially this will be strange for consumers, the market will likely adapt. Purchasers will continue to buy designer-like goods for the same reasons they want them today. *See supra* note 202.

287. Mencken, *supra* note 38, ¶ 40 n.125 (citing Schmidt, *supra* note 119, at 876); *see also supra* note 269 and accompanying text.

288. Several legal scholars have suggested the implementation of a copyright system similar to that in Europe. Among other things, this suggestion proposes to adopt the current one-year protection period afforded fashion designs in the European Union. *See Hagin, supra* note 18, at 382; Mencken, *supra* note 38, ¶ 40; Schmidt, *supra* note 119, at 877. It is noteworthy, however, that the French system of copyright actually provides a longer term of protection than other European countries. *See Scafidi, supra* note 150. Even a supporter of the one-year period has acknowledged that the French eighteen-month to two-year term is "closer to the appropriate length." Hagin, *supra* note 18, at 382.

289. *See supra* note 218.

290. *See Nurbhai, supra* note 114, at 519 (proposing a compulsory license system where, upon registration, "the designer would own the design exclusively for one month; however, upon publishing, selling, or showing the design in public, the designer would be required to license it"); Mencken, *supra* note 38, ¶¶ 40-43 (arguing that a compulsory license "would only allow the manufacturer to make his own interpretation of the design, not an exact replica"); Schmidt, *supra* note 119, at 877-80 (suggesting that "[a]s a prerequisite to copyright protection, designers [should] be required to agree to the non-discriminatory licensing of their designs," thereby mitigating "the elimination of moderately-priced apparel from the market").

291. *See Nurbhai, supra* note 114, at 519. For opponents who anticipate the flood of litigation

licensing schemes are already used for phonorecords, cable television, and noncommercial broadcasting, and could serve as the basis for the creation of the fashion design model.<sup>292</sup> Young designers would reap the benefits of allowing major manufactures, or even other designers, license registered designs.<sup>293</sup> Moreover, courts would be kept out of the “artistic realm” and the originality debate could essentially be avoided.<sup>294</sup>

On the whole, the Design Piracy Prohibition Act is on the right track. With a few minor adjustments, it might be fashion’s answer to the century-long debate over the protection of fashion designs.<sup>295</sup> Allowing the protection of designs would not only further the creative industry as a whole, but it would move the United States closer to meeting current international standards.<sup>296</sup> Even so, regardless of whether H.R. 5055 is the legislation that moves Congress to action, it has become evident that something needs to be done.<sup>297</sup> “[W]hen designers have shown lawmakers their fashions alongside

following the implementation of H.R. 5055, a compulsory license system would eliminate this issue by allowing the world to copy designs once they have been made public by a designer. *See supra* notes 215-16 and accompanying text; *see also* Schmidt, *supra* note 119, at 878. “The proposal differs from the status quo in one significant respect: the copyist would be required to pay a small royalty, or ‘license fee,’ to the original designer for each copy the copyist manufactures.” *Id.* Thus, the designer would be provided the opportunity to monopolize her designs without succumbing to endless litigation. “Rather than risk the high costs of defending an infringement action, copyists probably would pay the relatively low royalty payments.” *Id.* at 879.

292. *See* 17 U.S.C. §§ 111, 115, 116, 118. Compulsory license systems “eliminate the need for individual negotiations over license fees and are particularly useful where there are massive numbers of potential licensees of a work or where the number of infringing copies per copyist is small.” Schmidt, *supra* note 119, at 878 n.125.

293. *See* Mencken, *supra* note 38, ¶ 41 n.127. “Additionally, a license system could be set up to include both the royalty collection and a fund for enforcement, matching the system of ASCPA or BMI.” *Id.*

294. *See supra* Part V.B.1.a.ii. By keeping copyists out of litigation, the court will rarely, if ever, be faced with the originality issue, and opponents’ main contention will be assuaged.

295. *See supra* note 119.

296. The United States entered the Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”) on March 1, 1989. *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988). The Berne Convention was created to provide protection through copyright to its members. Tsai, *supra* note 206, at 464. Members of the Convention must provide such protection to other member states. *Id.* However, so far, the United States has only complied with its minimum requirements. *Id.* Under international laws, fashion designs are protected as a creative medium, while in the United States, they are offered no such protection. *Id.* “The U.S. constantly alleges that other countries are not doing enough to protect the copyrighted works of American authors, yet fails to extend its own copyright protection for certain works, most notably the creations of fashion designers.” Mencken, *supra* note 38, ¶ 19.

297. In its opinion upholding the FTC’s prosecution of the Millinery Creators’ Guild, the court recognized:

What passes in the trade for an original design of a hat or a dress cannot be patented or copyrighted. An “original” creation is too slight a modification of a known idea to justify the grant by the government of a monopoly to the creator; yet such are the whims and

the knockoffs, 'it becomes spectacularly clear' why these imitations are a form of flattery they can live without."<sup>298</sup>

## VII. CONCLUSION

The business of fashion is not one that is readily understood because it can mean entirely different things to different people. For some, it is nothing more than an economic opportunity to capitalize on the purchase power of society, and yet for others it is the most significant and personal mode of self expression.<sup>299</sup> And still, for those in the hub of its creation, fashion is at its heart an art form.<sup>300</sup> Perhaps this explains why "that singular business which lives somewhere between art and commerce" is such a controversial issue in the realm of intellectual property.<sup>301</sup>

In the third season of *Sex and the City*, Carrie and her friends travel to Los Angeles on vacation.<sup>302</sup> While shopping, Samantha is approached by a man whispering, "Fendi \$150."<sup>303</sup> She buys the bag, and over lunch Samantha shows off her "Fake Fendi" to the squeals of her friends proclaiming that "it looks so real!"<sup>304</sup> Excited by the opportunity to exercise

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cycles of fashion that the slight modification is of great commercial value. The creator who maintains a large staff of highly paid designers can recoup his investment only by selling the hats they design. He suffers a real loss when the design is copied as soon as it appears; the imitator in turn reaps a substantial gain by appropriating for himself the style innovations produced by the creator's investment. Yet the imitator may copy with impunity, and the law grants no remedy to the creator.

Millinery Creators' Guild v. FTC, 109 F.2d 175, 177 (2d Cir. 1940).

298. Woyke, *supra* note 151.

299. See EVANS, *supra* note 232 (discussing the expressionist nature of the fashion industry and its evolving comments on society); see also FASHION NOW, *supra* note 18, at 179 (quoting designer Tom Ford as claiming that "fashion is often a manifestation of a sociological or political climate"). This distinction is noteworthy because it shows the current attitudes toward fashion. There are many who view the current consumption-based nature of our society as a downfall. See Martin, *supra* note 11. They attribute this largely to the fashion industry. Yet, others who are involved in the industry, or those who have just grown to respect it, see the changing fashions as a growing art form. See *supra* note 12.

300. See FASHION NOW, *supra* note 18, at 147. Infamous fashion designers Domenico Dolce and Stefano Gabbana defined fashion in the following way: "Fashion is one of the expressions of the time we live in and of all changes that happen. It can have a specific position and make statements, but for us it is essentially a way of expressing creativity." *Id.*

301. THE FASHION BOOK, *supra* note 245, at 3. See Mencken, *supra* note 38, ¶ 45 ("The question of whether or not to grant copyright protection should consider the work of the designers and their economic interest, rather than the desires of the general public."). Because designers are the ones making the primary creative and monetary investment in the development of their designs, their concerns should be at the forefront of the debate. While Raustiala and Sprigman make educated contentions about the industry and IP protection, they openly ignore the needs of the designer for the sake of the economy. See *supra* note 191. Copyright, on the other hand, was enacted in order to protect the artist, albeit the young one, from the effects of the economy. See discussion *supra* Part V.B.1.b.

302. *Sex and the City: Sex and Another City* (HBO television broadcast Sept. 17, 2000).

303. *Id.*

304. *Id.*

her wallet, Carrie travels with Samantha to “Fake Fendi Paradise,” but when they get there she cannot bring herself to make a purchase.<sup>305</sup> Carrie muses, “I should have liked them, but staring into that trunk, they no longer looked like elegant Fendi bags. They just looked cheap. And even if everyone else thought it was real, I’d always know my bag came from a cardboard box in a trunk deep in the Valley.”<sup>306</sup> Although it is hard for me as a fashion enthusiast to accept that I may be forced to reduce my consumption of designer looks, like Carrie, I’d rather wait for the real thing.

The road ahead for fashion designers with respect to intellectual property protection is one paved with skepticism. Cynics are numerous and companies continue to resist changing the deep-rooted business practices United States manufacturers have developed as a result of design piracy.<sup>307</sup> But with the introduction of the Design Piracy Prohibition Act comes a hope that fashion designers will for once be respected and recognized, like those before them, for their creative contributions to our society.

Coco Chanel once said, “Those who create are rare; those who cannot are numerous. Therefore, the latter are stronger.”<sup>308</sup> With the potential passage of H.R. 5055, over 300 fashion designers hope to prove her wrong.<sup>309</sup>

Lynsey Blackmon<sup>310</sup>

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305. *Id.*

306. *Id.*

307. See Briggs, *supra* note 74, at 207-08.

308. ChanelAmour.com, <http://www.chanelamour.com/category/history/>.

309. See *supra* note 151 (noting the current membership total of the CFDA).

310. J.D. Candidate, 2008, Pepperdine University School of Law; B.A. in English Literature, 2005, University of Texas at Austin—School of Liberal Arts. I wish to thank my parents for indulging my passion and allowing me to re-tell embarrassing stories, and Seth Eaton for listening while I read draft after draft over dinner. Finally, I dedicate this Comment to my mentor and friend at W Magazine, Mayte Allende, who taught me what it means to love fashion, and most importantly, that being fashionable is not about how much money you spend but how creative you are. Mayte, thank you for your patience.

